Supreme Court, U.S.
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No. 07- (1)

IN THE
Supreme Court of the United States

STRYKER CORPORATION,

Petitioner,

v.

TRIMED, INCORPORATED,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

GREGORY J. VOGLER
Counsel of Record
ROBERT A. SURRETTE
MCANDREWS, HELD & MALLOY, LTD.
500 West Madison Street
Suite 3400
Chicago, IL 60661
(312) 775-8000

Attorneys for Petitioner

216247

COUNSEL PRESS
(800) 274-3321 • (800) 359-6859

QUESTIONS PRESENTED

1. Whether the Federal Circuit has eroded the public notice function served through a patent's prosecution history by disregarding a patent applicant's concessions concerning a patent claim feature in a bargained-for-agreement with the United States Patent and Trademark Office where a) the Patent Office Examiner stated in the written record that "[a]greement was reached that the expression of this feature in a means plus function format and better defining the holes of the plate would distinguish over the prior art of record" to allow the patent, b) the patent applicant then rewrote the claim language in the agreed-to "means plus function format" and secured issuance of the patent, but c) the Federal Circuit held that the claim language was not a "means plus function" element under 35 U.S.C. § 112, ¶ 6, thereby allowing the patent owner to escape summary judgment of non-infringement and depriving the public of the ability to rely on the patent's prosecution history in evaluating the metes and bounds of patent claims.

2. Whether the Federal Circuit erred in its statutory construction of 35 U.S.C. § 112, ¶ 6, as it has erred over a long period of time, by invoking a judicially-created exception to the statutory mandate of 35 U.S.C. § 112, ¶ 6, where the Federal Circuit avoids construing a claim element written in "means for performing a specified function" language under the statute which, in contrast and without any listed exceptions, states that a claim element "expressed as a means . . . for performing a specified function without the recital of structure, material or acts . . . **shall be construed** to cover the corresponding structure, material or acts described in the specification and equivalents thereof."

RULE 14.1(b) AND 29.6 STATEMENT

Pursuant to Supreme Court Rule 14.1(b), Petitioner Stryker Corporation ("Petitioner") states that all parties to the proceedings below appear in the caption of the case on the cover page.

Pursuant to Supreme Court Rule 29.6, Petitioner states that no publicly traded company owns 10 percent or more of Stryker Corporation.

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Stryker Corporation ("Petitioner") hereby petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The opinion and order of the United States District Court for the Central District of California ("District Court") granting summary judgment in favor of Petitioner is unreported and is set forth in the Appendix ("App.") at 18a-39a. The opinion and order of the United States Court of Appeals for the Federal Circuit reversing the judgment of the District Court is reported at 514 F.3d 1256 and is also set forth at App. 1a-13a. The Federal Circuit's order denying rehearing *en banc* is unreported and is reproduced at App. 43a-44a.

JURISDICTION

The District Court had jurisdiction to hear TriMed, Incorporated's ("Respondent") complaint pursuant to 28 U.S.C. §§ 1331 and 1338. The Federal Circuit had jurisdiction to hear Respondent's appeal pursuant to 28 U.S.C. § 1295(a)(1). The Federal Circuit rendered its decision on January 29, 2008. Petitioner filed a timely petition for rehearing *en banc* by the Federal Circuit, which was denied on March 10, 2008. This Court's jurisdiction, under 28 U.S.C. § 1254(1), is thus timely invoked.

STATUTORY PROVISIONS INVOLVED

This case concerns the proper interpretation of a patent claim element written as a means for performing a specified function, otherwise known as means-plus-function format. Section 112, paragraph 6 of Title 35 of the United States Code governs the proper interpretation of elements written in means-plus-function format in a patent claim. It provides:

> An element in a claim for a combination may be expressed as a means or a step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

STATEMENT OF THE CASE

This case raises important questions regarding two critical aspects of claim construction in patent law. First, this case raises a vital question regarding the public notice function served by a patent's prosecution history. May a court simply dismiss a patent's prosecution history when an applicant, to obtain the patent, makes an agreement with the United States Patent and Trademark Office ("Patent Office") regarding the scope and interpretation of a claim element? Second, this case raises fundamental questions regarding proper statutory interpretation of a federal statute. In particular, should a court be allowed to create a judicial exception to the express mandate of 35 U.S.C. § 112,

¶ 6, and as a result allow a patent owner to broaden impermissibly its claims during a later-initiated infringement action?

Perceiving fundamental problems with allowing an applicant to claim his or her invention using functional language, in 1946 this Court prohibited the use of means-plus-function language in patent claims. *See Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 9-12 (1946). In 1952, however, Congress addressed this issue with the enactment of 35 U.S.C. § 112, ¶ 6. While Congress determined that applicants could express their inventions in means-plus-function format, Congress concurrently attempted to rectify the indefiniteness problems that previously plagued such claim language. In particular, to prevent applicants from claiming their inventions in an impermissibly broad or ambiguous manner, Congress limited the scope of means-plus-function claim elements to those structures (or equivalents) that were recited in the specification for performing the claimed functions. *See* 35 U.S.C. § 112, ¶ 6.

By applying its own judicially-created exception to this federal statute, the Federal Circuit has eroded the safeguards put in place by Congress. Because the Federal Circuit does not apply the claim construction mandate of 35 U.S.C. § 112, ¶ 6 to all claim elements which invoke "means" language, the statutory safeguards are not universally applied to all such claim elements. Specifically, rather than universally apply the mandate of § 112, ¶ 6, the Federal Circuit only applies the statutory framework presumptively. *See, e.g., Biomedino, LLC v. Water Techs. Corp.*, 490 F.3d 946,

950 (Fed. Cir. 2007). If the Federal Circuit believes that the claim language recites "sufficient structure," then the Federal Circuit interprets the claim language without reference to the claim construction mandate set forth in § 112, ¶ 6. *Id.* Consequently, just like the pre-*Halliburton* era, applicants again are allowed to claim their inventions with language that is often times overly broad, indefinite and ambiguous.

This case epitomizes the Federal Circuit's problematic approach to means-plus-function claim elements. Here, Robert Medoff ("the Applicant") used the statutory "means for performing a specified function" language to express a critical claim element. Moreover, in exchange for receiving a patent monopoly from the government, the Applicant agreed with the Patent Office during an interview with the Patent Office Examiner that the critical aspect of his alleged invention would be expressed in means-plus-function format. Supplement Appendix ("Supp. App.") at SA-7. In other words, the Applicant agreed that his monopoly would be limited to the structures described in the specification, and equivalents thereof, that performed the claimed functions. The Applicant then proceeded to amend his patent claim to place expressly the "means for performing a specified function" language in the claims of the issued patent. Supp. App. at SA-8-SA-13. Nevertheless, accepting an argument raised by the patent owner (Respondent) to escape summary judgment of non-infringement against it, the Federal Circuit refused to invoke the statutory mandate of 35 U.S.C. § 112, ¶ 6. App. at 6a-10a. Without the statutory safeguards in place, the Federal Circuit allowed Respondent to expand its monopoly to include

structures not recited in the specification, or equivalents thereof, for performing the claimed functions.

The Federal Circuit's refusal to apply consistently 35 U.S.C. § 112, ¶ 6 results in problematic uncertainty regarding the scope of a patent's claims. In many cases, neither the government, the applicant, nor the public will know if a claim element will be interpreted narrowly as a means-plus-function element or broadly not as a means-plus-function element until the claim language is subjected to litigation. That litigation may not occur until years after the patent issues.

This Court, however, recognizes that "[t]he limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others, and the assurance that the subject matter will be dedicated ultimately to the public." *Gen. Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938). This case provides an excellent vehicle for the Court to reinforce the paramount importance of enabling the government, the applicant and most importantly the public to ascertain predictably the boundaries of a patent owner's monopoly. By addressing the proper statutory construction of 35 U.S.C. § 112, ¶ 6, this Court will provide the Patent Office, the applicants, the public, and the lower courts with much needed clarity regarding the scope of claim elements written with "means for performing a specified function" language.

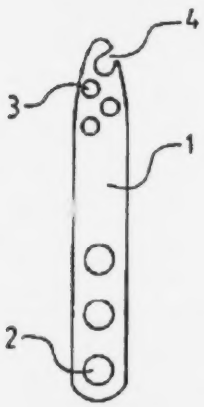
This case is a proper vehicle for this Court to address the role of the prosecution history in claim construction. A patent, like any other written instrument, should be interpreted in accordance with the intrinsic evidence.

In the context of patents, the intrinsic evidence includes the claims, the specification, and the prosecution history. In fact, alongside the claims and the specification, the prosecution history is a vital tool in claim construction. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 733 (2002) ("Prosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process. Estoppel is a 'rule of patent construction' that ensures that claims are interpreted by reference to those 'that have been cancelled or rejected.'"); *see also Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582-83 (Fed. Cir. 1996).

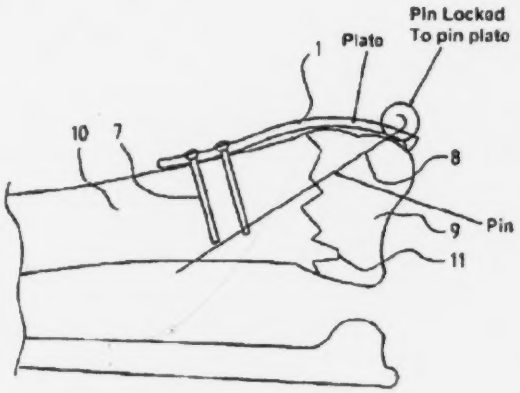
The public is entitled to rely on an applicant's express statements during patent prosecution when ascertaining the scope of protection afforded by the patent that ultimately issues. As a corollary, an applicant ought to be bound by any representations it made to or agreements it made with the Patent Office to obtain allowance of the patent. As such, in this case for example, Respondent should not be allowed to breach the agreement struck with the Patent Office in order to avoid a finding of non-infringement. The straightforward nature of the prosecution history in this case makes it a proper vehicle for this Court to address the significance of a patent's prosecution history in construing a patent.

The Technology at Issue

The technology at issue in this case is simple and straightforward. In general, United States Patent No. 5,931,839 ("the '839 patent") relates to the fixation of broken bones, in particular the fixation of fractures of the distal radius (the wrist). The technology described in the '839 patent discloses plates with special holes, screws and pins for fixing broken bones. Pictures of the plate/screw/pin assembly of the '839 patent are shown in the drawings below, which are taken from the figures of the '839 patent:



From Fig. 1
of the '839 Patent



From Fig. 5
of the '839 Patent

As shown in the above drawings, the bone fracture is shown at 11. The plate 1 is placed over the stable bone 10 and the fractured bone 9. At one end, the plate 1 has holes 2 for the insertion of screws 7. The screws 7 secure the plate to the stable bone 10. At the other end of the plate, there are holes 3 and/or special holes with slots 4 for the insertion of pins 8. The pins 8 slide axially

through the holes 3 or the hole/slot combination 4 into the fractured bone 9, across the fracture 11, and into the stable bone 10.

As described in the patent, but *not* shown in the drawings (other than the hole with a slot), a special hole has an additional structure to lock the pin to the plate so that the near end of the pin is stabilized against displacement in the plane of the plate. These additional necessary structures include: (1) a hole with a **slot**; (2) a **threaded hole** with threaded pins; (3) a hole with **locking means**; (4) an **undersized hole with a cut** extending from the hole to the edge of the plate; (5) a **slotted hole** joined by a slightly undersized hole; and (6) a hole used with one or more **threaded or slotted studs**. Supp. App. at SA-6.

Claim 1 is the only independent claim of the '839 patent. Currently at issue in this case is the construction of the last element of that claim reproduced in bold below. In full, claim 1 of the '839 patent reads:

> An implantable device for fixation of at least one fractured bone fragment to a stable bone fragment, said implantable device comprising an implantable plate having opposite end portions,
>
> fastening means for securing one end portion of said plate to stable bone,
>
> at least one fixation pin for penetrating said at least one fractured bone fragment, and traversing a fracture for entering the stable

> bone fragment and for being secured therein at a stable fixation site at a far end of said fixation pin,
>
> the opposite, near end of said pin being adapted for extending from the fractured bone fragment,
>
> said near end of said pin being engageable in one of a plurality of holes in the other end portion of the plate,
>
> said holes in said plate providing **means for allowing the pin to slide axially therein but preventing compression across the fracture, and stabilizing said near end of the pin against displacement in the plane of the plate**.

Supp. App. at SA-6 (emphasis added).

The Prosecution History

The Applicant, Robert Medoff, had a difficult time obtaining allowance of the '839 patent. When the Patent Office issued a final rejection of the pending claims of the '839 patent, the Applicant requested an interview with the Patent Office Examiner to discuss the final rejection of the claims. On August 17, 1998, the Patent Office Examiner conducted an interview with the Applicant and his lawyer. As memorialized in the Interview Summary written by the Patent Office Examiner, the Patent Office Examiner and the Applicant agreed that the Applicant could obtain allowance of the

claims if the Applicant wrote the last element of claim 1 in means-plus-function format and better defined the holes of the plate:

> The examiner explained the rejection to the applicant. Discussion centered around focusing on the structural difference between the applicant's pin/plate attachment and the conventional screw/plate attachment of the prior art (as shown for example by Lin). The configuration of the present device allows the pin to be attached to the plate in a sliding manner that prevents compression across the fracture. **Agreement was reached that the expression of this feature in a means plus function format and better defining the holes of the plate would distinguish over the prior art of record.**

Supp. App. at SA-7 (emphasis added).

Subsequently, the Applicant did in fact amend claim 1 of the '839 patent to include "means for performing a specified function" language. Supp. App. at SA-9. Moreover, the Applicant expressly told the Patent Office Examiner that the amendment was made "[i]n accordance with the determinations made at [sic] interview"—*i.e.*, the determination that the last element of claim 1 was to be written in means-plus-function format. Supp. App. at SA-11. The Patent Office allowed the claims of the '839 patent in light of the Applicant's amendment. No fair reading of this public record could reach any conclusion other than the one reached by the District Court—the last claim element of claim 1 is a "means plus function" claim element subject to 35 U.S.C. § 112, ¶ 6.

The District Court's Rulings

Respondent TriMed, Incorporated ("Respondent") filed the present lawsuit asserting that Petitioner's distal radius fracture fixation system allegedly infringes claims of the '839 patent in the United States District Court for the Central District of California ("District Court"). The District Court had jurisdiction to hear Respondent's case under 28 U.S.C. §§ 1331 and 1338. Petitioner denied Respondent's contention and filed counterclaims seeking a declaratory judgment that Petitioner's distal radius fracture fixation system does not infringe claims of the '839 patent and that the claims of the '839 patent are invalid and unenforceable.

Petitioner then moved for summary judgment of non-infringement. In its motion, Petitioner argued that under a proper construction of the last element of claim 1—"said holes in said plate providing means for allowing the pin to slide axially therein but preventing compression across the fracture, and stabilizing said near end of the pin against displacement in the plane of the plate"—the accused products did not infringe. Petitioner explained that the last element of claim 1 was a means-plus-function element that required a hole **plus another structure** to perform the claimed functions of (1) allowing the pin to slide axially but preventing compression across the fracture, and (2) stabilizing the near end of the pin against displacement in the plane of the plate. According to the Applicant's disclosure to the public in the patent's specification, the structures for performing the claimed functions are: (1) a hole with a **slot** for "preventing disengagement"; (2) a **threaded hole** to engage threaded pins; (3) holes used with

locking means, such as a locking nut; (4) an **undersized hole with a cut** for holding the pin; (5) a **slotted, undersized hole** for locking the pin; and (6) a hole used with one or more **threaded or slotted locking studs.** Supp. App. at SA-6. Because the accused products lack any additional structure working in combination with a hole, the accused products could not infringe claim 1 of the '839 patent as a matter of law.

Respondent opposed the summary judgment motion by arguing, in part, that, contrary to the Applicant's "agreement" with the Patent Office, the last element of claim 1 was not written in means-plus-function format. As such, Respondent argued that mere holes performed the claimed functions of allowing the pin to slide axially and stabilizing the pin to prevent displacement in the plane of the plate.

The District Court adopted Petitioner's claim construction position and determined that the claim element "said holes in said plate providing means for [performing two specified functions]" was written in means-plus-function format. App. at 35a-39a. Thus, this claim element required a structure in addition to a hole for performing the claimed functions. *Id.* Because the accused products have only holes, the District Court granted Petitioner's motion for summary judgment of non-infringement. *Id.*; *see also* App. at 18a-19a.

The Federal Circuit's Disposition

Respondent appealed the District Court's grant of summary judgment of non-infringement to the Federal Circuit. In doing so, Respondent argued that the last element of claim 1 was not written in means-plus-function format and as properly interpreted required mere holes to perform the claimed functions. The Federal Circuit agreed. Dismissing both the use of "means for performing a specified function" language in claim 1 and the Applicant's express written "agreement" with the Patent Office, the Federal Circuit reversed the District Court's grant of summary judgment. App. at 7a-11a. In essence, the Federal Circuit allowed Respondent to redraft a critical part of the claim—omitting the need for an additional structure, in combination with the holes, to perform the claimed functions. Petitioner timely requested rehearing *en banc*, which was denied on March 10, 2008. App. at 43a-44a.

REASONS FOR GRANTING THE PETITION

The Federal Circuit's decision to apply as only a rebuttable presumption the statutory mandate embodied in 35 U.S.C. § 112, ¶ 6 is contrary to the clear language of that statute. It conflicts with well-established principles of statutory interpretation outlined by this Court.

Congress enacted § 112, ¶ 6 to allow patent applicants to define their inventions in terms of functional language. As a consequence of doing so, however, the applicant's patent claims would be limited to structures, or equivalents, the applicant described

in the specification as performing the claimed functions. 35 U.S.C. § 112, ¶ 6. This statutory safeguard was put in place so that both the patent owners and the public at large would be able to ascertain, on the public record, the scope of the patent's protection.

With little fanfare or discussion of the issue, the Federal Circuit has developed a judicial rule that § 112, ¶ 6 only applies presumptively when the patent applicant invokes the statutory "means for performing a specified function" language. *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1536 (Fed. Cir. 1991) (holding that § 112, ¶ 6 applies even when the claim recites some structure); *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1584 (Fed. Cir. 1996) (stating that "use of the term 'means' (particularly as used in the phrase 'means for') generally invokes section 112(6) . . ."); *York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1574 (Fed. Cir. 1996) (holding that "the use of the word 'means' triggers a presumption that the invention used this term advisedly to invoke the statutory mandates for means-plus-function clauses"); *see also* William F. Lee & Eugene M. Paige, *Means Plus and Step Plus Function Claims: Do We Only Know Them When We See Them?*, 80 J. Pat. & Trademark Off. Soc'y 251, 257-63 (1998). In particular, under Federal Circuit case law if "sufficient structure" is recited in the claim element, the claim element is not interpreted under the statutory mandate of § 112, ¶ 6. *See, e.g., Biomedino*, 490 F.3d at 950; *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1427-28 (Fed. Cir. 1997).

Over the years, the Federal Circuit's application of this statutory provision has generated uncertainty regarding the scope of any claim element that invokes the statutory "means for performing a specified function" language. *See, e.g.*, Kimberly A. Moore, Markman *Eight Years Later: Is Claim Construction More Predictable?*, 9 Lewis & Clark L. Rev. 231, 242-43 (2005) (noting that the Federal Circuit's means-plus-function law is difficult to apply and "[t]his may support adoption of a black letter application standard; namely, if the term uses the word 'means,' it is a means-plus-function term . . ."); William F. Lee & Eugene M. Paige, 80 J. Pat. & Trademark Off. Soc'y at 252, 266-68 (noting that "although the broad outlines are now acquiring some definition, the law of what constitutes a means-plus-function claim is fraught with uncertainty . . ."). But, patent owners and the public at large have a critical need to understand the scope of a patent's protection based upon the public written record. Certainty in the application of 35 U.S.C. § 112, ¶ 6 would better allow patent owners to determine if a competitor truly was or was not infringing. Likewise, knowing whether or not interpretation under § 112, ¶ 6 would apply to a claim element would allow the public to better ascertain what activity may be an infringement or non-infringement for business planning purposes.

In this case, the Federal Circuit has generated greater uncertainty with its decision below by taking a further step away from § 112, ¶ 6 and applying special rules which ignore Patent Office agreements in the interpretation of patents. *Compare* App. at 6a-10a (rewriting Applicant's bargained-for-agreement) *with United States v. Joseph A. Holpuch Co.*, 328 U.S. 234,

238-40 (1946) (holding claim for damages barred where respondent failed to "abide by the appeal provisions of Article 15 of the contracts" because "[t]o do otherwise is to rewrite the contract") *and Front Row Theatre, Inc. v. Am. Mfr. Mutual Ins. Cos.*, 18 F.3d 1343, 1347 (6th Cir. 1994) (plaintiff not entitled to insurance coverage where cause of damage was specifically excluded from contract). Despite this Court's pronouncement that patents are like any other written document, the Federal Circuit construed Respondent's patent claims in a manner directly contrary to how any other court would interpret written or legal documents. In nullifying the very agreement that the Applicant made with the Patent Office in order to obtain allowance of its patent, the Federal Circuit called into question the very nature of the patent prosecution process and its public notice function.

I. THE FEDERAL CIRCUIT'S STATUTORY CONSTRUCTION IS CONTRARY TO THIS COURT'S PRECEDENT

Review by this Court is necessary so that this Court can address the proper statutory interpretation of 35 U.S.C. § 112, ¶ 6. The current construction adhered to by the Federal Circuit impermissibly inserts a judicially-created exception into the otherwise clear language of this statutory provision. As currently interpreted, the mandatory provisions of 35 U.S.C. § 112, ¶ 6 become merely a rebuttable presumption. The Federal Circuit's statutory construction has created uncertainty regarding the scope of a patent owner's rights that needs to be addressed by this Court.

A. The Federal Circuit's Interpretation Of § 112, ¶ 6 Resurrects The Problems Identified By This Court In *Halliburton*

In 1952, Congress enacted Section 112, paragraph 6 as "a targeted cure to a specific problem." *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 28 (1997). Specifically, this Court had determined previously in *Halliburton* that claim elements written in "means" or functional language did not meet the definiteness requirement embodied in § 112. *Halliburton*, 329 U.S. at 10. In prohibiting the use of "means" language, this Court delineated numerous problems with allowing applicants to claim their alleged invention with purely functional language. Namely, this Court was concerned that such claim elements were too broad and ambiguous to meet the goals of the Patent Act:

> Where the ingredients are all old the invention . . . consists entirely in the combination, and the requirement of the Patent Act that the invention shall be fully and exactly described applies with as much force to such an invention as to any other class, because if not fulfilled all three of the great ends intended to be accomplished by that requirement would be defeated. . . . (1.) That the government may know what they have granted and what will become public property when the term of the monopoly expires. (2.) That licensed persons desiring to practice the invention may know, during the term, how to make, construct, and use the invention.

> (3.) That other inventors may know what part of the field of invention is unoccupied.

Halliburton, 329 U.S. at 10 (*quoting Gill v. Wells*, 89 U.S. 1, 25-26 (1874)); *see also id.* at 12 ("Under these circumstances the broadness, ambiguity, and overhanging threat of the functional claim of [the patent-in-suit] become apparent.").

In response to *Halliburton*, Congress enacted § 112, ¶ 6. *See, e.g., Warner-Jenkinson*, 520 U.S. at 28. This new statutory provision allowed patent applicants to use "means" language in their patent claims. But, to cure the definiteness problems outlined by this Court, Congress provided an express mandate regarding the construction of these claim elements. Under the statute, an applicant is allowed to claim his or her invention "as a means or step for performing a specified function," but if the applicant does so "such claim **shall be construed** to cover the corresponding structure, material, or acts described in the specification or equivalents thereof." 35 U.S.C. § 112, ¶ 6 (emphasis added). In other words, "[s]ection 112 thus permits means-plus-function language in a combination claim, but with a 'string attached.' The 'attached string' limits the applicant to the structure, material, or acts in the specification and their equivalents." *Valmont Indus., Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1042 (Fed. Cir. 1993).

The patent statute is clear and mandatory. If an applicant writes a claim element in "means for performing a specified function" language, that claim element must be interpreted under 35 U.S.C. § 112, ¶ 6,

i.e., the claim element must be limited to the structures in the specification (or equivalents) for performing the claimed functions. Despite this clear mandate, over time the Federal Circuit has developed a loophole for applicants dissatisfied with the claims they negotiated for during patent prosecution. Under the Federal Circuit's case law, if an applicant uses the words "means for" with the recitation of functions to be performed in the claim element, then 35 U.S.C. § 112, ¶ 6 only creates a rebuttable presumption. *See, e.g., Biomedino*, 490 F.3d at 950. If, however, the claim element is written in the language permitted under § 112, ¶ 6 but also recites "sufficient structure," according to the Federal Circuit the claim element is no longer interpreted under the statute. *See, e.g., Sage Prods.*, 126 F.3d at 1427-28.

Unfortunately, what constitutes "sufficient structure" is often times uncertain, debatable, and open to subjective determinations. *Compare Unidynamics Corp. v. Automatic Prods., Int'l, Ltd.*, 157 F.3d 1311, 1319 (Fed. Cir. 1998) (interpreting "spring means" as subject to § 112, ¶ 6) *with Turbocare Div. of Demag Delaval Turbomachinery Corp. v. Gen. Elec., Co.*, 264 F.3d 1111, 1120-21 (Fed. Cir. 2001) (declining to interpret "compression spring means" as subject to § 112, ¶ 6).[1]

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1. For additional examples of the arbitrary and capricious results stemming from the application of the Federal Circuit's judicially-created exception to § 112, ¶ 6 *compare Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1375-76 (Fed. Cir. 2003) (finding insufficient structure in the claim element "means of booting said digital computer, said means of booting **including** a first set of commands, said first set of commands resident on said storage device . . ., and a second set of commands resident on a

(Cont'd)

Moreover, allowing an applicant to escape the ambit of § 112, ¶ 6 can lead to, as in this case, an impermissible broadening of the patent's scope such that the patent claims will cover products or processes that patent law did not contemplate.[2] Thus, the Federal Circuit has

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(Cont'd)

storage device external to said digital computer . . ." in part because use of "'including'—an open term— . . . suggests that the two sets of 'commands' are not sufficient structure; rather, something else is needed") (emphasis added) *with Searfoss v. Pioneer Consol. Corp.*, 374 F.3d 1142, 1145-46, 1149 (Fed. Cir. 2004) (finding sufficient structure in the claim element "actuation means for connecting said tension bail to said extension assembly . . . said actuation means **including** first and second pivot connections . . . and a midpoint on said respective first and second extension bail legs" despite the applicant's use of the open term "including") (emphasis added) and *compare also Overhead Door Corp. v. Chamberlain Group, Inc.*, 194 F.3d 1261, 1272-73 (Fed. Cir. 1999) ("first switch means" and "memory selection second switch means" do not recite sufficient structure even though structures in the specification were merely switches) *with MediaCom Corp. v. Rates Tech., Inc.*, 4 F. Supp. 2d 17, 27 (D. Mass. 1998) ("switch means" recites sufficient structure for performing the claimed functions, *i.e.* a switch). Indeed, when faced with the same exact claim element, judges of the Federal Circuit cannot even agree on how to apply their judicially created-exception. *See Cole v. Kimberly-Clark Corp.*, 102 F.3d 524 (Fed. Cir. 1996) (majority finding "perforation means" contained a sufficient recital of structure; dissent finding "perforation" was not a sufficient recital of structure).

2. This case typifies the broadening effect resulting from an applicant's escape of § 112, ¶ 6. Had the Federal Circuit properly interpreted the last element of claim 1, Respondent's

(Cont'd)

created the very problems outlined by this Court in *Halliburton*. As noted above, the *Halliburton* Court warned that use of purely functional claim language (without the safeguards later enacted by Congress) was problematic because the government may not know "what they have granted and what will become public property when the term of the monopoly expires." *Halliburton*, 329 U.S. at 10. Likewise, licensees will not know how to practice the invention nor will other inventors know "what part of the field of invention is unoccupied." *Id.*

This case exemplifies these very real problems. Here, the Patent Office expressly agreed with the Applicant that the last element of claim 1 was to be written in means-plus-function format. Supp. App. at SA-7. The Applicant, moreover, expressly indicated to the Patent Office that the claim element was amended in accordance with the Applicant's agreement with the

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(Cont'd)

patent would have been limited to a plate with a hole **plus another structure** that worked in combination with the hole to allow a pin to slide axially but preventing compression across the fracture and to stabilize the pin. But, since the Federal Circuit determined that the last element of claim 1 should not be interpreted under § 112, ¶ 6, Respondent's patent was broadened to include all plates with any type of hole that would allow a pin to slide axially and stabilize the pin against displacement in the plane of the plate. In other words, the Federal Circuit allowed Respondent to broaden a critical claim element, namely eliminating the requisite additional structure for performing the claimed functions (*e.g.* a hole with a slot, threaded hole with threaded pin, a hole with locking means, etc.). Respondent thereby escaped summary judgment of non-infringement against it.

Patent Office. Supp. App. at SA-11. Thus, when the '839 patent issued, the Patent Office and competitors in the field had every reason to believe, based on the fixed written record, that the last element of claim 1 was written in means-plus-function format. They had no reason to believe that years later Respondent would surprise everyone by arguing the complete opposite. The Federal Circuit, years after the '839 patent issued, determined that the last element of claim 1 is not written in means-plus-function format. App. at 7a-10a. Petitioner certainly had no way of knowing that § 112, ¶ 6 would **not** apply to the applicable means-plus-function claim element until the Federal Circuit ruled so nearly eight years after the '839 patent issued.

Indeed, contrary to the Federal Circuit's finding that holes are the only required structure, the Applicant and the Patent Office expressly agreed that the Applicant needed to "better defin[e] the holes" in order to obtain allowance. Supp. App. at SA-7. But, holes by themselves would not need better defining because "holes" are "holes." This conclusion is further buttressed by the specification which discloses six structures used in combination with a hole for performing the claimed functions: (1) a slot; (2) a threaded hole; (3) a locking nut; (4) an undersized hole; (5) a slotted, undersized hole; and (6) threaded or slotted studs. Supp. App. at SA-6.

Using functional language to delineate the boundaries of an invention is problematic. This Court in *Halliburton* noted some of these problems. Congress, as a result, enacted safeguards to ensure that claim elements written in "means for performing a specified function" language did not suffer these aforementioned

problems. The Federal Circuit's judicially-created presumptive—rather than mandatory— application of § 112, ¶ 6 weakens these safeguards and in turn resurrects the very problems that concerned this Court years ago. As a result, this Court's guidance is needed to properly interpret 35 U.S.C. § 112, ¶ 6.

B. Using A Judicially-Created Presumption To Allow Judicial Exceptions To The Mandate Of 35 U.S.C. § 112, ¶ 6 Violates Basic Principles Of Statutory Interpretation

The Federal Circuit's construction of § 112, ¶ 6 violates basic principles of statutory interpretation enunciated by this Court, namely this Court's instruction that exceptions should not be implied to statutory provisions. Just as these basic principles of statutory interpretation apply to any other statutory enactment, these same principles should apply with equal force to the provisions of the Patent Act.

As noted above, section 112 explicitly governs the claim interpretation of claim elements written in means-plus-function format. Specifically, § 112, ¶ 6 provides:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim **shall be construed** to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C. § 112, ¶ 6 (emphasis added).

This statutory provision is clear. It mandates interpretation under § 112, ¶ 6 when an applicant writes a claim element in "means for performing a specified function" language. It provides no exceptions. *See United States v. Rutherford*, 442 U.S. 544, 552 (1979) ("Exceptions to clearly delineated statutes will be implied only where essential to prevent 'absurd results' or consequences obviously at variance with the policy of the enactment as a whole."); *see also Lexecon, Inc. v. Milberg Weiss Bershad Hynes & Lerach*, 523 U.S. 26, 35 (1998) (noting that the statutory instruction "comes in terms of the mandatory 'shall,' which normally creates an obligation impervious to judicial discretion").

Notably, the statute does not provide that § 112, ¶ 6 is inapplicable when there is some recital of structure. *See, e.g., Laitram*, 939 F.2d at 1536 ("The recitation of some structure in a means plus function element does not preclude the applicability of section 112(6)."). Rather, the plain meaning of § 112, ¶ 6 requires that claim language using the words "means for," plus the recital of functions to be performed, shall be interpreted in accordance with 35 U.S.C. § 112, ¶ 6 in all circumstances. That the claim language may also describe one of the structures which may perform part or all of the claimed functions does not change the analysis. *Cf.* William F. Lee & Eugene M. Paige, 80 J. Pat. & Trademark Off. Soc'y at 266 n.106 (noting that although the Federal Circuit opted for a different interpretation, the use of the word "may" in the statute could be interpreted to "permit the patentee to use a means-plus-function claim form with the option of reciting structure"). In these fact situations, the structure described in the claim language may simply be one of or part of one of the

structures from the specification for the court to consider in construing the means-plus-function language. This result provides a consistent interpretation, without any loopholes, in all circumstances. *See* Kimberly A. Moore et al., *Patent Litigation And Strategy* 321-24 (2d ed. 2003) (suggesting that a "black letter rule" would be better than inconsistencies caused by current law); Kimberly A. Moore, 9 Lewis & Clark at 243 (same).

Nevertheless, as discussed above, the Federal Circuit does not apply § 112, ¶ 6 if the Federal Circuit determines that a claim element recites "sufficient structure." The creation of this judicial exception is contrary to the statutory mandate that claim elements "expressed as a means or step for performing a specified function . . . shall be construed to cover the corresponding structure . . . described in the specification and equivalents thereof." Indeed, this judicially-created exception conflicts with this Court's mandate that "federal courts do not sit as councils of revision, empowered to rewrite legislation in accord with their own conceptions of prudent public policy." *Rutherford*, 442 U.S. at 555.

The need for this Court's guidance is compelling. Recently, this Court has indicated a willingness to offer guidance in the construction of federal statutes that significantly affect patent rights. *See Merck KGaA v. Integra LifeSciences I, Ltd.*, 545 U.S. 193, 202-08 (2005); *see also Eli Lilly & Co. v. Medtronic, Inc.*, 496 U.S. 661 (1990) (interpreting 35 U.S.C. § 271(e)(1)). For example, in *Merck KGaA*, the Federal Circuit narrowly construed § 271(e)(1), the statutory infringement exemption for

acts "reasonably related to the development and submission of information under a Federal law" which regulates drug use. *Merck KGaA*, 545 U.S. at 205-06; 35 U.S.C. § 271(e)(1). Despite the breadth of § 271(e)(1), the Federal Circuit created uncertainty by limiting the statutory exemption to activities which actually produced information that ultimately was submitted to the FDA. *Merck KGaA*, 545 U.S. at 201, 206-07. The Federal Circuit interpreted § 271(e)(1) in this manner even though the statutory language provided no such limitation. The uncertainty created by this interpretation, in turn, unfairly expanded a patent owner's rights by allowing a patent owner to accuse exempted activities as infringement.

This Court reversed the Federal Circuit's statutory construction because the research process is often fraught with uncertainty. *Id.* at 206-07. In other words, not every course of experimentation will lead to a FDA submission. *Id.* As a result, the scope of the exemption as interpreted by the Federal Circuit was uncertain—one could never know at the time experimentation began if a FDA submission would ultimately be made and therefore if the exemption would apply. *Id.* In light of the statute's language (which did not narrowly limit the exempted activities as held by the Federal Circuit), this Court concluded that:

> There is simply no room in the statute for excluding certain information from the exemption on the basis of the phase of research in which it is developed or the particular submission in which it could be included.

Id. at 202.

Similarly, here, the scope of 35 U.S.C. § 112, ¶ 6 vastly impacts the scope of a patent owner's patent claims—the most critical part of a patent granting monopoly rights. The current interpretation of 35 U.S.C. § 112, ¶ 6, like the interpretation given to § 271(e)(1) by the Federal Circuit in *Merck KGaA*, creates uncertainty. Whereas in *Merck KGaA* one could never be certain if its activity fell under the statutory exemption until years later, here one could never be certain if its activity is infringing because it is impractical to know in some circumstances, like here, if a claim element avoids § 112, ¶ 6, until the Federal Circuit hangs its hat on analysis of whether the claim element recites "sufficient structure," whatever that means. The Federal Circuit's application of § 112, ¶ 6 has the effect of allowing a patent owner to expand improperly its patent rights in some situations and prevent competitors from engaging in lawful activity.

The Supreme Court has not yet addressed the proper interpretation of 35 U.S.C. § 112, ¶ 6. Petitioner believes that it is now appropriate to do so. The Federal Circuit's current construction is contrary to principles of statutory interpretation. This construction leads to the very problems of claim uncertainty, ambiguity and unwarranted broadness that caused this Court to initially question the appropriateness of "means for performing a specified function" claim language before the enactment of 35 U.S.C. § 112, ¶ 6.

II. THE FEDERAL CIRCUIT CREATED AN INTRA-CIRCUIT SPLIT REGARDING THE PUBLIC NOTICE FUNCTION OF A PATENT'S PROSECUTION HISTORY

The need for this Court's guidance is further augmented by the Federal Circuit's intra-circuit split regarding the proper role of a patent's prosecution history in the claim construction process. This Court has previously made clear that a patent is no different from any other legal instrument. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388-90 (1996). Like any other written instrument, such as a contract, a patent is to be interpreted by the judge and it is "to be construed . . . according to its tenor." *Id.* at 388. In line with this directive, the Federal Circuit generally interprets a patent consistently with the intrinsic evidence, which includes the prosecution history. *See, e.g., Schoenhaus v. Genesco, Inc.*, 440 F.3d 1354, 1358-59 (Fed. Cir. 2006); *Spring Window Fashions LP v. Novo Indus. L.P.*, 323 F.3d 989, 995 (Fed. Cir. 2003); *Sage Prods.*, 126 F.3d at 1425, 1432. Indeed, the Federal Circuit has held that the prosecution history is to be used for the precise issue here—determining whether 35 U.S.C. § 112, ¶ 6 applies. *See Cole*, 102 F.3d at 531-32. But, in this case, the Federal Circuit reversed course by interpreting the patent claim at issue in direct contravention of an explicit agreement between the Patent Office and the Applicant. App. at 7a-10a; *see also* Supp. App. at SA-7. This type of intra-circuit disagreement within the court with exclusive jurisdiction over patent cases is problematic, especially given that claim construction is an issue that arises in nearly every patent case.

This Court has not yet delineated a complete framework for judges to follow when construing patent claims. In this absence, the Federal Circuit has enumerated a general set of principles for the lower courts to follow. Of importance here, is the overarching principle that patent claims are generally to be interpreted in light of the intrinsic evidence, *i.e.*, the patent and its corresponding prosecution history. *See Vitronics Corp.*, 90 F.3d at 1582-83. Indeed, the Federal Circuit has repeatedly emphasized the importance of the prosecution history in claim interpretation:

> [The prosecution history] contains the complete record of all the proceedings before the Patent and Trademark Office, including any express representations made by an applicant regarding the scope of the claims. As such, the record before the Patent and Trademark Office is often of **critical significance** in determining the meaning of the claims.

Id. at 1582 (emphasis added); *see also Cole*, 102 F.3d at 531 ("We decide on an element-by-element basis, based upon the patent and prosecution history, whether § 112, ¶ 6 applies."). In short, the very "purpose of consulting the prosecution history in construing a claim is to exclude any interpretation that was disclaimed during prosecution." *Chimie v. PPG Indus., Inc.*, 402 F.3d 1371, 1384 (Fed. Cir. 2005) (internal quotations omitted).

In light of the importance attributed to the prosecution history, the Federal Circuit routinely binds an applicant to any agreement between the applicant

and the Patent Office as memorialized in the prosecution history. *See, e.g.*, *Schoenhaus*, 440 F.3d at 1359 ("If the additional limitation of rigidity in the Examiner's Amendment was improper or unnecessary, plaintiffs should have raised this issue by appeal before the PTO."); *Sage Prods.*, 126 F.3d at 1432 (stating that "[a] patentee is not free to retrade or renege on a deal struck with the PTO during patent prosecution"); *cf. Festo*, 535 U.S. at 734-41 (patentee presumptively bound under doctrine of prosecution history estoppel by subject matter surrendered during prosecution). Failure to so bind the applicant would completely vitiate the public notice function served by the applicant's statements in the prosecution history. *See Spring Window*, 323 F.3d at 995 (holding that "[w]ere we to accept [the patentee's] position, we would undercut the public's reliance on a statement that was in the public record and upon which reasonable competitors formed their business strategies."); *see also Sage Prods.*, 126 F.3d at 1425.

Even though all legal instruments should be interpreted consistently with their intrinsic evidence and even though the Federal Circuit's previous case law illustrated a propensity for doing just that, the Federal Circuit has now deviated from this well-established principle. As explained above, in negotiating for his patent, the Applicant and the Patent Office expressly agreed in writing that the last element of claim 1 would be written in means-plus-function format **to obtain issuance of the patent**. Supp. App. at SA-7. The Applicant then amended his patent claim to include the agreed-to statutory "means for performing a specified function" language in the patent claim, and told the Patent Office that he made the amendment in accordance with their agreement. Supp. App. at SA-9-SA-11.

To avoid a finding of non-infringement, Respondent persuaded the Federal Circuit to allow it to renege on the Applicant's deal with the Patent Office and now some eight years later to interpret the claim element **not** as a means-plus-function element. App. at 7a-10a; *see also* Supp. App. at SA-7. In essence, the Federal Circuit allowed Respondent to rewrite a critical element of its patent claim in order to broaden impermissibly the scope of the Applicant's bargained-for-agreement with the Patent Office. In doing so, the Federal Circuit created an intra-circuit split on how to handle what happened before the Patent Office. This is problematic because the public can no longer be certain that an applicant will be bound by his or her bargained-for-agreement with the Patent Office, and consequently the public can no longer be certain about the scope of protection afforded by a patent.

A court cannot rewrite a contractual provision to cover a situation that was expressly excluded from the contract. *See, e.g., Holpuch*, 328 U.S. at 238-40 (holding claim for damages barred where respondent failed to "abide by the appeal provisions of Article 15 of the contracts" because "[t]o do otherwise is to rewrite the contract"); *Front Row Theatre*, 18 F.3d at 1347 (plaintiff not entitled to insurance coverage where cause of damage was specifically excluded from contract); *cf. United States v. Am. Surety Co.*, 322 U.S. 96, 101-02 (1944) ("[W]e are not justified in rewriting the clear provisions of the contract to include what might well have been but was not inserted . . ."); *Am. Capital Corp. v. Fed. Deposit Ins. Corp.*, 472 F.3d 859, 865 (Fed. Cir. 2006) ("We cannot rewrite a contract or insert words to which a party has never agreed."). Analogously, a court

cannot rewrite patent claims to cover a product or process that the applicant expressly excluded from the patent's scope during the negotiation process with the Patent Office to obtain the patent grant in the first place. This Court's guidance is needed to reaffirm the binding affect of an applicant's bargained-for-agreement with the Patent Office.

CONCLUSION

To give proper direction to the Federal Circuit and the public on patent interpretation, the petition for a writ of certiorari should be granted.

Respectfully submitted,

GREGORY J. VOGLER
Counsel of Record
ROBERT A. SURRETTE
MCANDREWS, HELD & MALLOY, LTD.
500 West Madison Street
Suite 3400
Chicago, IL 60661
(312) 775-8000

Attorneys for Petitioner

APPENDIX

APPENDIX A — OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DECIDED JANUARY 29, 2008

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2007-1327

TRIMED, INCORPORATED,

Plaintiff-Appellant,

v.

STRYKER CORPORATION,

Defendant-Appellee.

Appeal from the United States District Court for the Central District of California in case no. 06-CV-1918, Judge Manuel L. Real.

DECIDED: January 29, 2008

Before LINN, DYK, and MOORE, *Circuit Judges*.

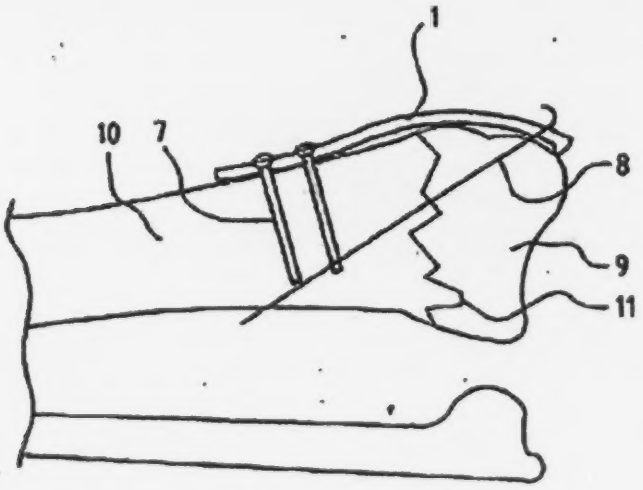
MOORE, *Circuit Judge*.

Plaintiff-appellant TriMed, Inc. (TriMed) appeals the summary judgment of noninfringement granted in favor of defendant-appellee Stryker Corporation (Stryker) by the United States District Court for the

Central District of California. Because the district court construed the relevant claim language incorrectly, we reverse.

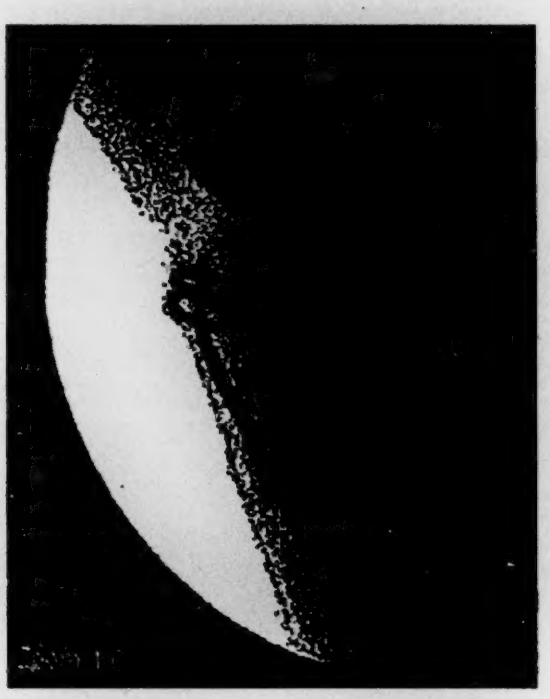
BACKGROUND

TriMed owns U.S. Patent No. 5,931,839 ('839 patent), which pertains to an implantable device for fixing bone fractures using screws, pins, and a plate with holes on one end for receiving screws and on the opposite end for receiving pins. In one embodiment of the '839 patent, the plate is fitted across a bone fracture such that the pin holes are positioned over the fractured bone fragment and the screw holes are positioned over the stable bone fragment. The screws affix the plate to the stable bone fragment. The pins fixate the fracture by passing through the pin holes of the plate, traversing the fracture such that the pins penetrate the fractured bone fragments and embed in the stable bone fragment. Figure 5 of the '839 patent illustrates this embodiment:



Appendix A

Stryker manufactures and sells implantable wrist fracture fixation devices that also involve screws, pins, and plates with holes. The following x-ray depicts the implantation of one such device:



As shown, Stryker's plate has been implanted on the distal radius. Pins have been inserted distally through the fractured bone fragment at an angle into the stable bone fragment. Screws have been inserted proximally to secure the plate to the stable bone fragment.

Appendix A

TriMed sued Stryker, alleging that Stryker's wrist fracture fixation devices infringe the '839 patent. Claim 1, the only independent claim at issue, reads as follows:

> An implantable device for fixation of at least one fractured bone fragment to a stable bone fragment, said implantable device comprising an implantable plate having opposite end portions, fastening means for securing one end portion of said plate to stable bone, at least one fixation pin for penetrating said at least one fractured bone fragment, and traversing a fracture for entering the stable bone fragment and for being secured therein at a stable fixation site at a far end of said fixation pin, the opposite, near end of said pin being adapted for extending from the fractured bone fragment, said near end of said pin being engageable in one of a plurality of holes in the other end portion of the plate, *said holes in said plate providing means for allowing the pin to slide axially therein but preventing compression across the fracture, and stabilizing said near end of the pin against displacement in the plane of the plate.*

'839 Patent col.6 ll.17-32 (emphasis added).

Stryker moved for summary judgment of noninfringement, asserting that the phrase, "said holes in said plate providing means for allowing the pin to slide

axially therein but preventing compression across the fracture, and stabilizing said near end of the pin against displacement in the plane of the plate," is a means-plus-function limitation governed by 35 U.S.C. § 112 ¶ 6. Stryker argued, based upon two separate grounds, that this means-plus-function limitation is not present in the accused devices. First, according to Stryker, the language at issue requires surgeons to perform the functions of "allowing the pin to slide axially therein but preventing compression across the fracture" and "stabilizing said near end of the pin against displacement in the plane of the plate." Because, Stryker contended, its accused devices do not by themselves perform the claimed functions and that it does not supply the surgeons who may use the devices to perform the claimed functions, it cannot be held liable for infringement. Second, Stryker argued that the only corresponding structures disclosed in the specification of the '839 patent for performing the claimed functions are "hole[s] plus some other structure." As the accused devices contain holes and nothing more, Stryker asserted that it did not infringe on the '839 patent.

Adopting Stryker's proposed claim construction and signing without any modification Stryker's Rule 56 Statement of Facts and Conclusions of Law, the district court entered summary judgment of noninfringement against TriMed. TriMed timely appealed, and we have jurisdiction over this appeal pursuant to 28 U.S.C. § 1295(a)(1).

Appendix A

DISCUSSION

I.

The task of determining whether the relevant claim language contains a means-plus-function limitation is, as with all claim construction issues, a question of law that we review de novo. *Cybor Corp. v. FAS Techs. Inc.*, 138 F.3d 1448, 1455-56 (Fed. Cir. 1998) (en banc). Use of the word "means" in claim language creates a presumption that § 112 ¶ 6 applies. *See Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583 (Fed. Cir. 1996). If, in addition to the word "means" and the functional language, the claim recites sufficient structure for performing the described functions in their entirety, the presumption of § 112 ¶ 6 is overcome—the limitation is not a means-plus-function limitation. *See Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1360 (Fed. Cir. 2004) ("[T]he fact that a particular mechanism . . . is defined in functional terms is not sufficient to convert a claim element containing that term into a 'means for performing a specified function' within the meaning of section 112(6)."); *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1427-28 (Fed. Cir. 1997). Sufficient structure exists when the claim language specifies the exact structure that performs the functions in question without need to resort to other portions of the specification or extrinsic evidence for an adequate understanding of the structure. *See Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1376 (Fed. Cir. 2003); *see also Envirco Corp. v. Clestra Cleanroom, Inc.*, 209 F.3d 1360, 1365 (Fed. Cir.

2000) (finding that "baffle means" defeated the § 112 ¶ 6 presumption because "the term 'baffle' itself imparts structure").

The district court erred in concluding that the language at issue in claim 1 was means-plus-function language that invoked § 112 ¶ 6. To be sure, the claim discloses functions for the holes—allowing a pin to slide axially through the pin plate while preventing compression across the bone fracture, and stabilizing the exposed end of the pin against displacement in the plane of the plate. As our precedent makes clear, the presence of the word "means" and the articulation of a function is not the end of the inquiry. Just as clearly, the claim articulates the structure for performing the claimed functions—the holes. The functional language defines the size and shape of the claimed holes. The interior of the holes must be shaped to allow pins to slide through axially while the boundaries of the holes must be sized appropriately to hold the pins in place and limit their movement across the plane of the plate. The claim language makes clear that the structure for performing these functions is the holes themselves.

Since the claim language clearly identifies the structure for performing the functions in claim 1, it was unnecessary and inappropriate for the court to employ § 112 ¶ 6 and to hold that there must be a structure in addition to the holes (such as a slot) for performing these functions. Even if we were to construe this as a § 112 ¶ 6 claim, the specification discloses an embodiment that has precisely the same structure that is found in the

accused devices. The specification states: "In one embodiment the pins 8 are bent over the superficial surface of the plate 1 as stated above." '839 Patent col.5 ll.24-25. The reference is to an earlier part of the specification, which stated that: "The rigidity of pin fixation of the fracture fragment is considerably improved by having it pass through one of the small holes 3 and possibly a tight slot 4 in the pin plate 1 which has been secured to the proximal fragment 10. After the pin 8 is placed, it can be bent over the superficial surface of the plate 1 to keep it from migrating."[1] *Id.* col.4 ll.56-61.

Stryker argues that the prosecution history of the '839 patent dictates that the claim limitation at issue does not recite sufficient structure for performing the described functions and instead must be read as requiring "hole [s] plus another structure." Specifically, Stryker points to an interview summary that states, "Agreement was reached that the expression of [the configuration of the pin to be attached to the plate in a sliding manner that prevents compression across the fracture] in a means-plus-function format and better defining the holes of the plate would distinguish over the prior art of record."[2] Because TriMed subsequently

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1. Additional structures for performing the claimed functions beyond mere holes, such as slots and other means for snap engagement of the pin to the plate, are recited in dependent claims not discussed in this opinion. *See, e.g.*, '839 Patent col.6 ll.36-39.

2. A statement that use of means-plus-function language would help overcome prior art does not magically transform

(Cont'd)

amended claim 1 to include the claim language in dispute, Stryker contends that the language must be construed as a means-plus-function limitation.

We disagree. While TriMed did use the word "means" in its amendment, its attorney remarks accompanying the amendment indicate that it intended for holes by themselves to constitute structure sufficient for allowing pins to slide axially through without compressing the fracture and stabilizing the pin from displacement across the plane of the plate. As the remarks put forth:

> The invention provides for stabilization of the end of the pin projecting from the fractured bone fragment without compromising the securing of the fractured bone segment to the stable bone segment without compression at the fracture. This is achieved by utilization of the pin plate 1 which has holes at one end portion for being fixed to stable bone while the opposite end has holes for engaging the protruding end of the pin, so as to prevent displacement of the protruding end of the pin in the plane of the pin plate and wherein the hole provides means for allowing the pin to slide axially in the hole in the pin plate but preventing compression across the fracture.

(Cont'd)
language that clearly does not meet our legal tests for § 112 ¶ 6 into means-plus-function language.

Nowhere in those remarks does TriMed suggest the importance of any structure in addition to holes, as Stryker would have us believe. *See Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531 (Fed. Cir. 1996) (explaining that the claim drafter's "perfunctory addition of the word 'means' did nothing to diminish the precise structural character" of the claim limitation). The prosecution statement does not even suggest that structure in addition to holes is required.

For the foregoing reasons, the claim language at issue recites sufficient structure on its face for performing the claimed functions, and therefore, contrary to the district court's interpretation, does not involve a means-plus-function limitation.

II.

We review the district court's grant of summary judgment without deference, reapplying the same standard required of the court below. *Lacavera v. Dudas*, 441 F.3d 1380, 1382 (Fed. Cir. 2006). Summary judgment is appropriate only "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed.R.Civ.P. 56(c).

Stryker's motion for summary judgment of noninfringement was premised solely upon reading the claim language at issue as a means-plus-function

limitation. Having properly construed the relevant claim language as falling outside the ambit of § 112 ¶ 6, we hold that Stryker has failed to demonstrate that there is no genuine issue of material fact that its accused devices do not infringe on the '839 patent. By Stryker's own admission, the structural limitation of holes in claim 1 is certainly present in its accused devices.[3]

Moreover, TriMed has adduced enough evidence to establish, at minimum, a genuine issue of material fact as to whether Stryker's accused devices perform the claimed functions. TriMed submitted a declaration from Dr. Leon Benson, an orthopedic hand surgeon, which stated that the holes in Stryker's accused devices perform both claimed functions based on his review of x-rays of the implanted Stryker plates and Stryker's operative technique manuals. TriMed also submitted a declaration from Dr. Robert Medoff, an orthopedic hand surgeon and the inventor behind the '839 patent, that stated that, based on an analysis of a product sample of Stryker's plates and its operative technique manual, pins can be slid axially through the pin holes in Stryker's

---

3. With a side-by-side comparison of figure 5 of the '839 patent and the x-ray of Stryker's implanted plate, it is hard to imagine any significant structural differences between the two. Indeed, Stryker was unable to point out any differences on appeal, only contending during oral argument that figure 5 does not show whether the pin has been inserted through a hole or a hole with some other structure. As the proper construction of claim 1 encompasses embodiments using holes to receive pins—with or without some other structure—this argument is unconvincing.

plates such that compressive force across a fracture is avoided, and that the holes are "small enough to secure the pin from lateral movement thus stabilizing the pin from translational displacement in the plane of the plate."

Stryker's only counterargument below, which the district court adopted—that it did not supply the surgeons who were purportedly required to perform the claimed functions of the '839 patent—is wholly unpersuasive. No credible reading of the claim language requires human input to perform the functions of the pin holes in TriMed's plate. Stryker's only response on appeal—that "the accused devices do not permit the end of the pin to be locked to the pin plate"—is similarly unavailing. Locking the pin to the plate is simply not a requirement of the claim language. Thus, because the summary judgment of noninfringement is inappropriate, we reverse.

CONCLUSION

Because the claim language of the '839 patent articulates sufficient structure for performing the functions of allowing pins to slide axially through the pin plate and stabilizing said pins from movement across the plane of the plate of the claimed invention, we determine that the district court improperly interpreted the pin holes claim limitation as governed by § 112 ¶ 6. In light of the proper claim construction, the grant of

summary judgment of noninfringement must be reversed. We remand for further proceedings consistent with our opinion and in view of the entire record.[4]

REVERSED AND REMANDED

4. Given our holding vacating the summary judgment of noninfringement, the time for discovery ought to be reinstated as originally scheduled in this case. The seventeen days of discovery should be fully restored.

APPENDIX B — JOINT STIPULATION OF THE UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA, WESTERN DIVISION DATED AND FILED MARCH 28, 2007

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION

Case No. CV-06-1918 R(SHx)

TRIMED, INC.,
a California corporation,

Plaintiff,

v.

STRYKER CORP.,
a Michigan corporation,

Defendant.

JOINT STIPULATION OF DISMISSAL OF STRYKER CORPORATION'S COUNTERCLAIM OF INVALIDITY WITHOUT PREJUDICE

THE PARTIES HEREBY AGREE AND STIPULATE TO THE FOLLOWING:

1. On March 28, 2006, TriMed, Inc. ("TriMed") filed its Complaint against Stryker Corporation ("Stryker") alleging infringement of U.S. Patent No. 5,931,839 ("the '839 patent").

2. Stryker answered on May 19, 2006, denying the Complaint, asserting affirmative defenses, and alleging counterclaims seeking declarations of noninfringement and invalidity.

3. TriMed filed its reply to Stryker's counterclaims on June 6, 2006.

4. On January 16, 2007, Stryker filed a motion for summary judgment asserting that Stryker does not infringe any asserted claim of the '839 patent either literally or under the doctrine of equivalents.

5. On March 19, 2007 ("March 19th Order"), the Court issued an Order granting Stryker's motion for summary judgment of noninfringement that the accused Stryker products do not infringe any asserted claims of the '839 patent, either literally or under the doctrine of equivalents. The Order further dismissed with prejudice TriMed's Complaint against Stryker.

6. The March 19th Order does not constitute a final judgment because it did not dispose of all the claims in the action. *See Pause Technology LLC v. Tivo Inc.*, 401 F.3d 1290 (Fed. Cir. 2005). Namely, the March 19th Order did not address Stryker's counterclaim that the claims of the '839 patent are invalid.

7. Accordingly, the parties jointly stipulate that Stryker's counterclaim of invalidity is hereby dismissed without prejudice.

Respectfully submitted,

By s/ Mark Grossman
Lee F. Grossman
Mark M. Grossman
Jeffrey M. Drake
GROSSMAN LAW OFFICES
29 South LaSalle Street, #1210
Chicago, Illinois 60603

Attorneys for Plaintiff,
TRIMED INCORPORATED

Respectfully submitted,

By s/ Robert Surrette
Gregory J. Vogler
Robert A. Surrette
Sara J. Bartos
McANDREWS, HELD & MALLOY
500 West Madison Street, 34th Floor
Chicago, Illinois 60661

Attorneys for Defendant,
STRYKER CORPORATION

IT IS SO ORDERED

Dated: March 28, 2007

s/ Manuel Real
Honorable Manuel L. Real
Judge, United States District Court

APPENDIX C — MINUTES OF PROCEEDINGS OF THE UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA DATED MARCH 19, 2007

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
CIVIL MINUTES - GENERAL

CASE NO.: CV-06-1918-R Date: March 19, 2007

TITLE: TRIMED INC V. STRYKER CORP

PRESENT:

HON. MANUEL L. REAL, JUDGE

William Horrell	*Cindy Nirenberg*
Deputy Clerk	Court Reporter

ATTORNEYS PRESENT FOR PLAINTIFFS:
Mark Grossman
Robert Garretson

ATTORNEYS PRESENT FOR DEFENDANTS:
Robert Surrette
Morgan Tovey

PROCEEDINGS: Defendant's motion for summary judgment of noninfringement of '839 patent

The Court GRANTS the motion, and signs the proposed uncontroverted facts and conclusions of law, and the proposed judgment.

MINUTES FORM 90	*4 min*
CIVIL -- GEN	Initials of Deputy Clerk *WH*

APPENDIX D — JUDGMENT OF THE UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA, WESTERN DIVISION DATED AND FILED MARCH 19, 2007

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION

CASE NO. CV-06-1918 R(SHx)

TRIMED, INC.
a California corporation,

Plaintiff,

v.

STRYKER CORP,
a Michigan corporation,

Defendant.

JUDGMENT GRANTING DEFENDANT STRYKER'S MOTION FOR SUMMARY JUDGMENT OF NONINFRINGEMENT OF THE '839 PATENT

Date: March 19, 2007
Time: 10:00 a.m.
Hon. Manuel L. Real

[PROPOSED] JUDGMENT

Having fully considered Defendant Stryker Corporation's ("Stryker") Motion for Summary Judgment of Noninfringement of the '839 Patent, TriMed, Inc.'s

("TriMed") response thereto, Stryker's reply, the declarations, exhibits, and memoranda submitted therewith and the relevant authorities cited, and the arguments and materials presented at the hearing,

IT IS HEREBY ORDERED AND JUDGED AND DECREED:

1. The accused products do not infringe any asserted claim of U.S. Patent No. 5,931,839 either literally or under the doctrine of equivalents;

2. Defendant's Motion for Summary Judgment of Noninfringement of U.S. Patent No. 5,931,839, in favor of Stryker and against plaintiff TriMed, is granted; and

3. As summary judgment on all counts has been rendered against Plaintiff TriMed, Plaintiff TriMed's Complaint is hereby DISMISSED WITH PREJUDICE.

IT IS SO ORDERED

s/ Manuel L. Real
Hon. Manuel L. Real
UNITED STATES DISTRICT JUDGE

Dated: March 19, 2007

APPENDIX E — STATEMENT OF UNCONTROVERTED FACTS AND CONCLUSIONS OF LAW IN SUPPORT OF STRYKER'S MOTION FOR SUMMARY JUDGMENT OF NONINFRINGEMENT OF THE '839 PATENT SIGNED BY HON. MANUEL L. REAL ON MARCH 19, 2007

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION

CASE NO. CV-06-1918 (SHx)

TRIMED, INC.
a California corporation,

Plaintiff,

v.

STRYKER CORP,
a Michigan corporation,

Defendant.

STATEMENT OF UNCONTROVERTED FACTS AND CONCLUSIONS OF LAW IN SUPPORT OF STRYKER'S MOTION FOR SUMMARY JUDGMENT OF NONINFRINGEMENT OF THE '839 PATENT

Date: March 19, 2007
Time: 10:00 a.m.
Hon. Manuel L. Real

Appendix E

Statement Of Uncontroverted Facts And Conclusions Of Law

Defendant Stryker Corp. ("Stryker") filed its Motion for Summary Judgment of Noninfringement of the '839 Patent on January 8, 2007 ("Motion"). In its Motion, Stryker contends that none of the accused products infringes any asserted claim of the U.S. patent no. 5,931,839 ("the '839 patent"), and plaintiff TriMed, Inc. ("TriMed") has not carried its burden of proving infringement.

The Findings of Fact Not Genuinely Disputed and Conclusions of Law In Support are set forth below. *See* Fed. R. Civ. P. 52.

I. FINDINGS OF FACT NOT GENUINELY CONTESTED

A. The Parties

1. Defendant Stryker is a Michigan corporation having a principal place of business in Kalamazoo, Michigan. Stryker develops, manufactures, and markets specialty surgical and medical products.

2. Plaintiff TriMed is a California corporation having a principle place of business in Valencia, California. TriMed designs and sells orthopedic medical devices for the fixation of fractures. TriMed is the alleged assignee of the '839 patent.

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B. The History Of The Case

3. TriMed filed its complaint of patent infringement against Stryker on March 28, 2006. ("Complaint," Docket No. 1.)

4. Stryker filed an answer, affirmative defenses, and counterclaims on May 19, 2006. ("Answer," Docket No. 17.)

5. TriMed filed a reply to Stryker's counterclaims on June 6, 2006. ("Reply," Docket No. 20.)

6. TriMed provided responses to Stryker's First Set of Interrogatories on September 27, 2006. (Ex. 1, Plaintiff's Responses To Defendants' *[sic]* First Set of Interrogatories.) On December 6, 2006, December 26, 2006, and January 10, 2007, TriMed supplemented its responses to Stryker's First Set of Interrogatories. (Ex. 2, Plaintiff's Supplemental Responses To Defendants' [sic] First Set of Interrogatories; Ex. 3, Plaintiff's Supplemental and Second Supplemental Responses to Defendants' *[sic]* First Set of Interrogatories; Ex. 4, Plaintiff's Supplemental Response to Defendants' *[sic]* Interrogatory No. 2.)

C. The '839 Patent

7. The '839 patent relates to a plate having holes, screws, and pins for fixing broken bones. (Ex. 5, '839 patent.)

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8. Figures 1, 4, and 5 of the '839 patent, reproduced below, illustrate "a top view of a radio pin plate according to one embodiment of the invention," "an exploded view of one embodiment of the invention," and "one embodiment of the invention fixed to the radius," respectively. (*Id.* at Figures 1, 4, and 5; and 3:50-51, 55-58.)

9. One "primary objective" of the alleged invention of the '839 patent is to "satisfy the goal of providing rigid fixation of fracture fragments while allowing immediate motion of a joint." (*Id.* at 3:35-37.)

10. TriMed has asserted claims 1, 2, and 7-11 against Stryker. (Ex. 6, 8/23/06 Letter from J. Drake to B. Surrette.)

11. Claim 1, the only independent claim of the '839 patent, recites:

> An implantable device for fixation of at least one fractured bone fragment to a stable bone fragment, said implantable device comprising an implantable plate having opposite end portions,
>
> fastening means for securing one end portion of said plate to stable bone,
>
> at least one fixation pin for penetrating said at least one fractured bone fragment, and traversing a fracture for entering the stable bone fragment and for being secured therein at a stable fixation site at a far end of said fixation pin,
>
> the opposite, near end of said pin being adapted for extending from the fractured bone fragment,

> said near end of said pin being engageable in one of a plurality of holes in the other end portion of the plate,
>
> said holes in said plate providing means for allowing the pin to slide axially therein but preventing compression across the fracture, and stabilizing said near end of the pin against displacement in the plane of the plate.

(Ex. 5, '839 patent, claim 1.)

12. The '839 patent specification discloses that "the actual dimensions [of the holes and the pins] to be used are decided by the surgeon in each case based on the specific circumstances such as fracture site, fragment size, bone condition, etc." (*Id.* at 4:42-45.) In addition, "[t]he number of pins 8 used and their angle of insertion is decided in each case by the surgeon depending on the site and size of the specific fracture or fractures." (*Id.* at 5:60-63).

13. The specification of the '839 patent discloses:

> If a hole 3 with a slot 4 at the distal portion 5 of the plate 1 is used, the pin 8 will be placed first, and the plate 1 slid along the surface of the bone 10 to engage the pin 8. In one embodiment the entrance slot 4 is slightly undersized and capable of slight widening as the pin passes through the slot. This way, the

> plate 1 will "snap" as the pin 8 is passed into the slot 4, preventing disengagement.

(*Id.* at 5:3-10.)

14. The specification of the '839 patent discloses:

> In another embodiment, threaded pins 8 are used which pass through threaded holes within the plate 1.

(*Id.* at 5:25-27.)

15. The specification of the '839 patent discloses:

> Optionally the pins 8 are locked with locking means such as a locking nut. This provides fixation of the pin 8 in space in both a transverse plan (in the plan of the plate 1) and an axial plane (along the axis of the pin 8).

(*Id.* at 5:27-31.)

16. The specification of the '839 patent discloses:

> In a further embodiment (not shown) the openings 3 for receiving the pins 8 are slightly undersized with a cut extending from the hole 3 to the edge of the plate 1.

(*Id.* at 5:34-36.)

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17. The specification of the '839 patent discloses:

> Alternatively, a slotted hole 3 is used which joins a slightly undersized hole 3, instead of a slightly larger hole. In this circumstance, as the pin 8 is snapped into the hole 3, it is effectively locked into place.

(*Id.* at 5:45-48.)

18. The specification of the '839 patent discloses:

> In a further embodiment (not shown) the pin plate 1 is furnished with one or more threaded studs. The pin 8 is hooked around one stud and locked against the pin plate 1 with a threaded locking nut on the stud. Instead of locking the pin around the stud, the stud may have a slot for receiving the pin 8. After the pin has been placed in the slot a locking nut is screwed onto the stud to lock the pin 8 in the slot of the stud.

(*Id.* at 5:49-56.)

19. The specification of the '839 patent discloses:

> The fixation of the pins 8 at the pin plate 1 is accomplished in different ways in different embodiments of the invention. In one embodiment the pins 8 are bent over the

superficial surface of the plate 1 as stated above.

(*Id.* at 5:22-25.)

D. The Accused Products

20. TriMed alleges that the following plate models, used in conjunction with K-wires, infringe the asserted claims of the '839 patent: 54-25400, 54-25401, 54-25402, 54-25403, 54-25404, and 54, 25405. (Ex. 1, Plaintiff's Responses To Defendants' *[sic]* First Set Of Interrogatories, at 3; Ex. 3, Plaintiff's Supplemental and Second Supplemental Responses to Defendants' *[sic]* First Set of Interrogatories, at 5.)

21. Two of the accused plates are reproduced below from photographs in a product brochure (Ex. 7, Bates Nos. SC 000455-462, Universal Distal Radius System, Operative Technique, 1000-405-017, Rev. A, 2005, at 00457):

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E. TriMed's Discovery Responses

22. In response to Stryker's Interrogatory No. 4 requesting that TriMed "set forth in a claim chart or otherwise explain how each element or limitation of each [asserted] claim is found in [the accused products]," TriMed stated:

> Regarding claim 1, Stryker's pin-plate products are implantable plate devices which fix at least one fractured bone fragment to a stable bone fragment. The plates have opposite end portions; the end portion with smaller holes typically used near or at the situs of the fractured bone fragment. Stryker sells fastening means (screw) for securing one end of the plate to the stable bone fragment. Stryker sells a fixation pin which pierces and passes through the fractured bone fragment. The fixation pin likewise pierces the stable bone, and the opposite end of the pin extends from the fractured bone fragment and into one of the holes at the fractured bone fragment end of the pin-plate, i.e., opposite the plate-end containing the screw(s). The pin is capable of moving in and/or out of the hole in the plate. The plate structure prevents the fracture from being compressed and stabilizes the pin.
>
> Stryker directly and literally infringes claim 2 of the '839 patent since, in addition to having all of the claim limitations of claim 1, one of

the holes in Stryker's pin-plate products is located in the plate and is near the entrance of the fixation pin into the bone fragment.

Stryker directly and literally infringes claim 7 of the '839 patent since, in addition to having all of the claim limitations of claim 1, the pin-plate products sold by Stryker are shaped to conform to the shapes of the stable and fractured bone fragments.

Stryker directly and literally infringes claim 8 of the '839 patent since, in addition to having all of the claim limitations of claim 1, one of the fastening means for securing the Stryker pin-plate to the stable bone fragment can be a screw(s).

Stryker directly and literally infringes claim 9 of the '839 patent since, in addition to having all of the claim limitations of claim 1, the Stryker fixation pin used with the Stryker pin-plate device is bendable back to the face of the pin-plate which prevents the pin and plate from separating from one another.

Stryker directly and literally infringes claim 10 of the '839 patent since, in addition to having all of the claim limitations of claim 1, Stryker's fixation pin contains a smooth portion to allow for the piercing and entry into the fractured bone fragment.

> Stryker directly and literally infringes claim 11 of the '839 patent since, in addition to having all of the claim limitations of claim 1, the Stryker fixation pins used with its pin-plate system are bendable by hand and have a diameter between 0.35 inch and 0.062 inch.

(Ex. 1, Plaintiff's Responses to Defendants' *[sic]* First Set of Interrogatories, at 3-5.)

23. In response to Stryker's Interrogatory No. 12 requesting the factual bases for TriMed's infringement allegations, TriMed stated:

> [Plaintiff] has observed Stryker's devices and products which infringe the '839 Patent offered for and/or sold at the American Academy Association of Hand Surgeons conference and other orthopedic meetings of doctors around the United States. Such devices infringe because they meet all of the limitations of claims 1, 2, 7, and 9-11.

(*Id.* at 10.)

24. In its supplemental response to Stryker's Interrogatory No. 4, TriMed stated:

> Stryker's pin-plate products, identified in response to Interrogatory No. 3, directly and literally infringe claims 1, 2, and 7 through 11. IN addition to the response regarding

> claim 1, Stryker's pin-plate products are implantable plate devices which fix at least one fractured bone fragment to a stable bone fragment. Stryker sells fastening means (screws) for securing one end of the plate to the stable bone fragment. Stryker sells a fixation pin which pierces and passes through the fractured bone fragment. Stryker's fixation pin likewise pierces the stable bone, and the opposite end of the pin extends from the fractured bone fragment and into one of the holes at the fractured bone fragment end of the pin-plate, i.e., opposite the end of plate containing the screw(s). Stryker's pin is capable of axially moving in and out of the hole in the plate; the size and shape of the holes limit the pin from migrating transversely in relation to the holes.

(Ex. 2, Plaintiff's Supplemental Responses to Defendants' *[sic]* First set of Interrogatories, at 5.)

25. In its supplemental response to Stryker's Interrogatory No. 12, TriMed stated:

> TriMed further states it has observed Stryker's devices and products which infringe the '839 Patent offered for and/or sold at the American Academy of Orthopaedic Surgeons instructional course during May 2004 in Chicago, Illinois. Such devices infringe

> because they meet all of the limitations of claims 1, 2, 7, 8, and 7-11 *[sic]*.

(*Id.* at 10.)

26. In its second supplemental response to Stryker's Interrogatory No. 4, TriMed stated:

> TriMed also believes Stryker product numbers 54-25402, 54-25403, 54-25404, and 54-25405 infringe the '839 Patent claims but Stryker has not provided requested samples to date and thus Plaintiff cannot complete its analysis. Upon receipt of said products, if TriMed determines these products infringe the claims of he '839 Patent, it will supplement this response.

(Ex. 3, Plaintiff's Supplemental and Second Supplemental Responses to Defendants' *[sic]* First Set of Interrogatories, at 5.)

27. In its responses and supplemental responses to Stryker's Interrogatories, TriMed did not provide any evidence that surgeons have used or are using the accused products in an infringing manner. (*Id.* at 5; Ex. 1, Plaintiff's Responses to Defendants' *[sic]* First Set of Interrogatories, at 3-5, 10; Ex. 2, Plaintiff's Supplemental Responses to Defendants' *[sic]* First Set of Interrogatories, at 5, 10.)

Appendix E

II. CONCLUSIONS OF LAW

A. Legal Principles of Summary Judgment

28. Summary judgment "shall be rendered forthwith" where "there is no genuine issue as to any material fact" and "the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56 (c).

29. The Federal Circuit routinely affirms summary judgment of noninfringement. *See, e.g., Norian Corp. v. Stryker Corp.*, 432 F.3d 1356 (Fed. Cir. 2005); *Biagro Western Sales, Inc. v. Grow More, Inc.*, 423 F.3d 1296 (Fed. Cir. 2005); *V-Formation, Inc. v. Benetton Group SpA*, 401 F.3d 1307 (Fed Cir. 2005); *C.R. Bard, Inc. v. United States Surgical Corp.*, 388 F.3d 858 (Fed. Cir. 2004); *Phonometrics, Inc. v. Westin Hotel Co.*, 319 F.3d 1328 (Fed. Cir. 2003); *TechSearch L.C. v. Intel Corp.*, 286 F.3d 1360 (Fed. Cir. 2002); *Talbert Fuel Sys. Co. v. Unocal Corp.*, 347 F.3d 1355 (Fed. Cir. 2003); *Novartis Corp. v. Ben Venue Labs.*, 271 F.3d 1043 (Fed. Cir. 2001); *Ballard Med. Prods. v. Allegiance Healthcare Corp.*, 268 F.3d 1352 (Fed. Cir. 2001).

30. In a patent infringement action, "the accused infringer . . . is entitled to summary judgment, on the ground of noninfringement, by pointing out that the patentee failed to put forth evidence to support a finding that a limitation of the asserted claim was met by the structure in the accused devices." *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1578 (Fed. Cir. 1989). *See also Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23 (1986).

Appendix E

B. Legal Principles of Patent Infringement

31. To prove infringement of an asserted claim, TriMed must show, by a preponderance of the evidence, that every limitation in the claim appears in the accused product. *Rohm & Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1092 (Fed. Cir. 1997); *see also Zygo Corp. v. Wyco Corp.*, 79 F.3d 1563, 1568 (Fed. Cir. 1996).

32. If an independent claim is not infringed, then any dependent claim depending from that independent claim cannot be infringed. *See Wahpeton Canvas Co. v. Frontier, Inc.*, 870 F.2d 1546, 1552 n.9 (Fed. Cir. 1989).

33. A claim for patent infringement involves a two-step inquiry. *Biagro Western*, 423 F.3d at 1301. First, the court construes the asserted claims as a matter of law. *Id.* After the claims are construed, the next issue is to determine whether the accused device infringes the properly construed claims. *Id.*

C. The Accused Products Do Not Infringe The '839 Patent As A Matter Of Law

34. The accused products do not infringe the '839 patent because they do not have "holes in said plate providing means for allowing the pin to slide axially but preventing compression across the fracture, and stabilizing said near end of the pin against displacement in the plane of the plate" as required by claim 1.

35. Because at least one claim limitation of independent claim 1 is not present in the accused products, there can be no infringement as a matter of law.

36. Claim elements that are written in means-plus-function form are interpreted in accordance with 35 U.S.C. § 112, ¶ 6, which provides:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

37. The statute permits a claim element to be expressed as a means for performing a specified function. *Symbol Techs., Inc. v. Opticon, Inc.*, 935 F.2d 1569, 1575 (Fed. Cir. 1991). "[T]he scope of such a claim is not limitless, but is *confined to structures expressly disclosed* in the specification and corresponding equivalents." *Id.* (emphasis added). *See also In re Donaldson Co.*, 16 F.3d 1189, 1195 (Fed. Cir. 1994) *(en banc); Alpex Computer Corp. v. Nintendo Co.*, 102 F.3d 1214, 1222 (Fed. Cir. 1996).

38. An equivalent structure in the context of the statute "results from an insubstantial change which adds nothing of significance to the structure, material,

or acts disclosed in the patent specification." *Valmont Indus., Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1043 (Fed. Cir. 1993).

39. Literal infringement of a § 112, ¶ 6 claim limitation requires that the relevant structure in the accused product perform the identical function recited in the claim and be identical or "equivalent" to the corresponding structure in the specification. *See Odetics, Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1267 (Fed. Cir. 1999). Under a modified version of the function-way-result methodology described in *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (1950), two structures may be "equivalent" for purposes of § 112, ¶ 6 if they perform the identical function, in substantially the same way, with substantially the same result. *See Odetics*, 185 F.3d at 1267. "When a court determines that the 'way' and/or 'result' is/are substantially different under a 35 U.S.C. section 112, paragraph 6 equivalents analysis, a patentee cannot prevail under the doctrine of equivalents for the same reason(s)." *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1365 (Fed. Cir. 2000).

40. The first step in a means-plus-function claim analysis is to define the function(s) being claimed. *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376 (Fed. Cir. 2001); *Medtronic, Inc. v. Advanced Cardiovascular Sys., Inc.*, 248 F.3d 1303, 1311 (Fed. Cir. 2001). The next step is to identify "the corresponding structure, material, or acts described in the specification" for performing the claimed function. *Budde*, 250 F.3d at 1376; *Medtronic*, 248 F.3d at 1311.

Appendix E

1. TriMed Cannot Establish Direct Infringement Because The Accused Plates Do Not Perform The Claimed "Preventing Compression" and "Stabilizing [The] Near End Of The Pin" Functions

41. The functions in the last means-plus-function claim limitation of claim 1 are: (1) allowing the pin to slide axially but preventing compression across the fracture; and (2) stabilizing the near end of the pin against displacement in the plane of the plate.

42. The accused plates do not perform these claimed functions or their equivalents. Accordingly, Stryker does not infringe the asserted claims of the '839 patent.

43. Stryker cannot be adjudged to be an infringer simply because the accused products are capable of being made into an infringing device by a surgeon. *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1310 (Fed. Cir. 2005).

2. The Accused Products Do Not Contain The Structure Disclosed In The '839 Patent Specification Or Its Equivalent For Performing The Claimed "Preventing Compression" and "Stabilizing" Functions

44. The accused plates do not contain the structure disclosed in the '839 patent specification or its equivalent for performing the claimed functions of allowing the pin to slide axially but preventing compression across the

fracture, and stabilizing the near end of the pin against displacement in the plane of the plate.

45. The scope of the means-plus-function claim limitations of claim 1 is confined to those structures which are expressly disclosed in the specification of the '839 patent and corresponding equivalents. *Symbol Techs.*, 935 F.2d at 1575.

46. Because the accused products do not perform the claimed functions or their equivalents, and do not contain the structure disclosed in the '839 patent specification or its equivalent for performing those functions, the accused products do not infringe the claims of the '839 patent literally or under the doctrine of equivalents as a matter of law.

III. CONCLUSION

47. For the above reasons, the accused products do not infringe the asserted claims of the '839 patent either literally or under the doctrine of equivalents. Stryker is entitled to summary judgment of noninfringement as a matter of law.

IT IS SO ORDERED.

Date March 19, 2007
s/ Hon. Manuel L. Real
United States District Judge

Appendix E

Dated: January 16, 2007

Respectfully submitted,

s/ Gregory J. Vogler
Gregory J. Vogler (*pro hac vice*)
Robert A. Surrette (*pro hac vice*)
Sara J. Bartos (*pro hac vice*)
McANDREWS, HELD
& MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312) 775-8100

Tamara M. Rudolph (SBN 228940)
REED SMITH LLP
355 South Grand Avenue, Suite 2900
Los Angeles, CA 90071-1514
Telephone: (213) 457-8000
Facsimile: (213) 457-8080

Morgan W. Tovey (SBN 136242)
William Ross Overend (SBN 180209)
REED SMITH LLP
Two Embarcadero Center, Suite 2000
San Francisco, California 94111-3922
Telephone: (415) 543-8700
Facsimile: (415) 391-8269

Attorneys for Defendant and
Counter-Plaintiff
STRYKER CORP.

APPENDIX F — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA, WESTERN DIVISION DATED AND FILED FEBRUARY 20, 2007

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION

No. CV-06-1918 R(SHx)

TRIMED, INCORPORATED,

Plaintiff,

v.

STRYKER CORPORATION,

Defendant.

ORDER DENYING TRIMED, INC.'S *EX PARTE* MOTION TO EXTEND DATES

Judge: Manuel L. Real
Ctrm: 8

The Court has reviewed the papers and arguments related to TriMed, Inc.'s Ex-Parte Motion To Extend The Dates For: (1) Serving TriMed's Damage Expert Report; (2) Filing Its Opposition To Stryker's Motion For Summary Judgment And TriMed's Counter-Motion for Summary judgment, And (3) Authorizing Documents To Be Filed Under Seal.

Appendix F

IT IS HEREBY ORDERED THAT:

1. TriMed, Inc.'s Motion is DENIED.

2. TriMed, Inc. is precluded from submitting any expert report in this case;

3. TriMed, Inc. must file its Opposition to Stryker's Motion for Summary Judgment no later than March 5, 2007; and

4. TriMed, Inc. is precluded from conducting further third-party discovery in this case.

IT IS SO ORDERED

Dated: Feb. 20, 2007

s/ Manuel L. Real
Honorable Manuel L. Real
Judge, United States District Court

APPENDIX G — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DENYING PETITION FOR REHEARING AND PETITION FOR REHEARING EN BANC FILED MARCH 10, 2008

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2007-1327

TRIMED, INCORPORATED,

Plaintiff-Appellant,

v.

STRYKER CORPORATION,

Defendant-Appellee.

Appeal from the United States District Court for the Central District of California in case no. 06-CV-1918, Judge Manuel L. Real.

ORDER

A petition for rehearing en banc having been filed by the Appellee, and the matter having first been referred as a petition for rehearing to the panel that heard the appeal, and thereafter the petition for rehearing en banc having been referred to the circuit judges who are in regular active service,

Appendix G

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on March 17, 2008.

FOR THE COURT,

s/ Jan Horbaly
Jan Horbaly
Clerk

Dated: 03/10/2008

cc: Mark M. Grossman
Gregory J. Vogler

APPENDIX H — 35 U.S.C. § 112, ¶ 6

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

(2)

No. 07-1537

FILED
JUL 11 2008
OFFICE OF THE
SUPREME COURT

In The

Supreme Court of the United States

STRYKER CORPORATION,

Petitioner,

v.

TRIMED, INCORPORATED,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF FOR THE RESPONDENT IN OPPOSITION

LEE F. GROSSMAN
Counsel of Record
NIRO, SCAVONE, HALLER & NIRO
181 West Madison Street
Suite 4600
Chicago, Illinois 60603
(312) 236-0733

MARK M. GROSSMAN
GROSSMAN LAW OFFICES
29 South LaSalle Street
Suite 1210
Chicago, Illinois 60602
(312) 621-9000

Counsel for Respondent

July 11, 2008

COCKLE LAW BRIEF PRINTING CO. (800) 225-6964
OR CALL COLLECT (402) 342-2831

QUESTIONS PRESENTED

1. Whether Petitioner has presented compelling reasons to grant the Petition, where the Federal Circuit did not invoke 35 U.S.C. §112, ¶6 in interpreting a claim term that recites structure which performs the claimed function.

2. Whether Petitioner has presented compelling reasons to grant the Petition, where the Federal Circuit used the patent's prosecution to interpret a claim term differently from the Petitioner.

CORPORATE DISCLOSURE STATEMENT PURSUANT TO SUPREME COURT RULE 29.6

Respondent TriMed, Incorporated does not have a parent corporation and there is no publicly held company that owns 10% or more of its stock.

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STATUTES

Title 35 U.S.C. §112, ¶6 ..... *passim*

RULES

Sup.Ct.R. 10 8

INTRODUCTION

This is a patent infringement suit, and there are two issues presented. First, whether Title 35 U.S.C. §112, ¶6 must always be invoked if a patent's claim includes the word "means." Second, whether the Federal Circuit properly interpreted the file history of the patent-in-suit.

Petitioner asks this Court to review the Federal Circuit's holding wherein the claim uses the term "means," but 35 U.S.C. §112, ¶6 was not invoked since there was sufficient structure recited in the claim to perform the claimed function. Petitioner argues that not invoking 35 U.S.C. §112, ¶6 to a claim term that uses the term "means" is a "judicially-created" exception to statutory mandate of 35 U.S.C. §112, ¶6, however, Petitioner's reading of the statute is incorrect. The statute clearly states that §112, ¶6 is invoked when structure is not recited in a claim. The Federal Circuit held that sufficient structure was recited, hence, §112, ¶6 need not be invoked. There was no err in the Federal Circuit's statutory construction of 35 U.S.C. §112, ¶6.

Petitioner incorrectly asserts that "the Federal Circuit has eroded the public notice function" of a prosecution history by "disregarding" it in its claim interpretation. The Federal Circuit discussed the prosecution history of the patent-in-suit, and used it to interpret the claim term in dispute. Petitioner's Brief, pp. 8a-10a. Petitioner simply disagrees with

the Federal Circuit's claim interpretation and the impact the file history had on that interpretation.

STATEMENT OF THE CASE

I. The Parties

TriMed, Incorporated ("TriMed") is a corporation located in California that manufactures and sells orthopedic implant products to hospitals and surgical centers located throughout the world. TriMed was started by orthopedic surgeon Dr. Robert Medoff and two partners in 1997 and now has over 200 sales representatives. Dr. Medoff is the inventor of the U.S. Patent No. 5,931,839 (the '839 Patent) which has been assigned to TriMed. Stryker is a Michigan corporation also in the field of orthopedic implant products. The patent and infringing device at issue pertain to a wrist fixation implant.

II. The Technology

A wrist fracture, also known as a distal radius fracture, results in the bone breaking into one or more "fractured bone fragments" and a "stable bone fragment." The fractured fragment is the small distal part of the bone toward the hand that is broken away from the remaining stable fragment which extends proximally toward the forearm.

One product used by surgeons to repair wrist fractures consists of a thick plate and screws wherein

a surgeon opens the skin to expose the fracture and position a thick metal plate across the fracture. The surgeon rotates a screw into the stable fragment until it is secured therein. To secure the fractured fragment to the thick plate, the surgeon rotates a screw into the fractured fragment. As the screw is tightened, the screw head limits the axial movement of the screw going into the bone, however, the continued rotation of the screw, which is required to fully secure the fractured fragment, causes the fractured fragment tc migrate up and against the plate. Thus, both fractured fragments are secured to the plate by way of two separate screws. This procedure has significant drawbacks.

First, in order to capture the fractured fragment and lock it to the plate, the screw must have thick threads. This requires the surgeon to make a large hole in the fractured fragment, often causing secondary fragmenting of the fractured fragment. Also, if the bone is small or osteoporotic, which is often the case, the screw threads simply cannot capture the fractured fragment. Another significant problem of this method occurs as the screw is tightened and the fractured fragment is forced to migrate up and against the plate. This causes an undesirable compressive force across the fracture which can cause significant problems such as the fractured fragment shattering.

To overcome these problems, Dr. Medoff conceived and developed the "Pin Plate," which is the '839 patented invention. The Pin Plate was a radical

breakthrough which greatly simplified the surgical process, and most importantly, significantly improved recovery with better long-term effects. In the orthopedic industry, TriMed's patented Pin Plate is considered revolutionary. Certain figures of the '839 Patent follow:

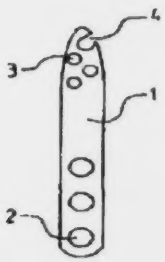

Fig. 1

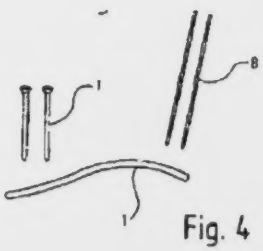

Fig. 4

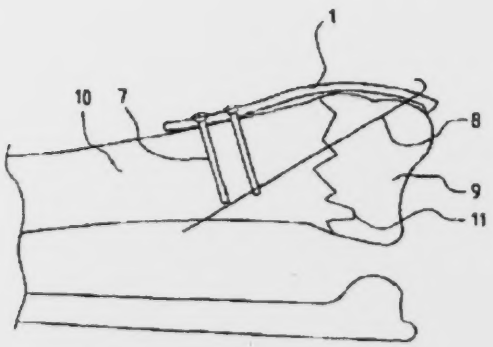

Fig. 5

Looking at Figure 1, a plate 1 has screw holes 2 and pin holes 3. Fig. 4 illustrates the pins 8, screws 7 and side view of the plate 1, and Figure 5 is a top view of a distal portion of the wrist bone (the "distal radius") with an implanted Pin Plate showing the

stable fragment 10, fractured fragment 9 and the line of fracture 11. (The forearm is to the left of figure 5 and the hand is to the right of figure 5.) For illustrative purposes, to implant a Pin Plate, Figure 5 shows a thin pin 8 (also called a "k-wire") that a surgeon slides into the fractured fragment 9 so the pin 8 crosses the fracture 11. One end of the pin 8 terminates within the stable fragment 10, and the other end of the pin is extended beyond the fractured fragment 9 and across the fracture 11.

A thin plate 1 is then slid over the exposed end of the pin 8 and is positioned on the bone so it crosses the fracture 11, with the part of the plate having screw holes 2 positioned on the stable fragment 10 and the part of the plate having pin holes 3 positioned on the fractured fragment 9. Screws 7 are inserted though screw holes 2 in the plate 1 and into the stable fragment 10. The exposed end of the pin 8 is cut and the remaining exposed end is bent to form a "J" hook, so the end of the pin can be inserted into another pin hole 3 in the plate 1 or can lie on the plate surface.

The key to the Pin Plate is this: (1) a thin pin captures and fixates the fractured fragment, and (2) the holes in the plate allow the pin to slide axially which prevents compression along the fracture while at the same time stabilizes the pin by preventing the end of the pin from twisting, bending or otherwise moving across the top surface of the plate (the plane of the plate). That is, (1) the interior of the hole allows the pin to axially slide therein and through the

fractured bone fragment, across the fracture and into the stable bone fragment, thereby preventing compression across fracture (because the fragmented bone fragment is not pulled-up to the plate during fastening) and (2) the circumferential surface of the hole stabilizes the near end of the pin against displacement in the plane of the plate; i.e., it forms a boundary which the near end of the pin cannot cross, thus preventing twisting, bending, or other movement across the top surface of the plate.

Thus, using the patented Pin Plate, the thin pin fixates the fractured fragment. The sole function of the plate is to provide holes to allow the pin to axially slide (to prevent compression) and to stabilize the pin from movement across the plane of the plate.

The patented Pin Plate solved two significant problems: (1) because thin pins (as compared to thick screws) are used, additional fracturing of the fractured fragment does not occur when capturing the small or sometimes osteoporotic fragments; and (2) compression across the fracture is prevented since the holes allow the pins – which are the fixation tools – to slide axially.

III. The Decisions At The Lower Courts

The District Court for the Central District of California granted summary judgment for noninfringement without a written opinion. The District Court entered judgment for Petitioner and merely

signed Petitioner's Statements of Fact and Law, though highly disputed, as the Court's own.

The Court of Appeals for the Federal Circuit ("the Federal Circuit") reversed the District Court's decision, and in so doing, interpreted the only disputed claim term. Contrary to Petitioner's argument, the Federal Circuit interpreted the relevant statute, 35 U.S.C. §112, ¶6, exactly as the statute is written. The statute states that an element in a claim may be expressed as a "means" for performing a specified function *without the recital of structure*, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. The Federal Circuit held that although the claim term contains the word "means," it did not invoke 35 U.S.C. §112, ¶6 because there was sufficient structure in the claim describing the means. Petitioner's Brief, p. 7a.

The Federal Circuit stated that with a side-by-side comparison between Figure 5 of the '839 Patent and Stryker's accused product, "it is hard to imagine any significant structural differences between the two." (Petitioner's Brief, p. 11a)

REASONS FOR DENYING THE PETITION

The decision by the Federal Circuit below does not conflict with a decision of this Court, previous decisions by the Federal Circuit, nor the statutory language of 35 U.S.C. §112, ¶6.

Contrary to the issues raised in Petitioner's Statement of the Case, the Federal Circuit's decision did not create a "judicial exception" to 35 U.S.C. §112, ¶6. Title 35 U.S.C. §112, ¶6 is invoked when a claim limitation is written in means-plus-function language without the recitation of structure. The Federal Circuit held that the claim limitation at issue contains sufficient structure, thus, 35 U.S.C. §112, ¶6 was properly not invoked.

Further, the Federal Circuit did not "simply dismiss a patent's prosecution history," rather it expressly considered the prosecution history in interpreting the claim language. Petitioner's Brief, pp. 8a-10a.

Petitioner's Petition for Writ of Certiorari should be denied since it has not carried its burden of demonstrating any compelling reasons for the Petition to be granted. *See* Sup.Ct.R. 10.

I. The Federal Circuit Correctly Interpreted The Last Element Of Claim 1 By Not Invoking 35 U.S.C. §112, ¶6

Title 35 U.S.C. §112, ¶6 states that when an element is written in a means-plus-function format without structure to perform the function, the structure is limited to that disclosed in the specification and equivalents thereof:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function *without the recital of*

> *structure, material, or acts in support thereof*, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. 35 U.S.C. §112, ¶6 (emphasis added)

Thus, if the claim recites structure, with or without the word "means," that element is not a means-plus-function element under 35 U.S.C. §112, ¶6. This clear reading of the statute has been the established law. *Cross Med. Prod., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1304 (Fed. Cir. 2005) ("anchor seat means"); *TI Automotive Sys., Inc. v. VDO North Am., LLC*, 375 F.3d 1126, 1135 (Fed. Cir. 2004) ("pumping means"); *Envirco Corp. v. Clestra Cleanroom, Inc.*, 209 F.3d 1360 (Fed. Cir. 2000) ("baffle means" was not a means-plus-function); *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531 (Fed. Cir. 1996) ("perforation means").

The Federal Circuit first addressed this issue in *York Products, Inc. v. Central Tractor Farm & Family Center*, 99 F.3d 1568, 1574 (Fed. Cir. 1996). In addressing 35 U.S.C. §112, ¶6 the court held that if the claim element uses the word "means" but also recites the structure to perform the means, the element is not subject to 35 U.S.C. §112, ¶6 because "the express structural limits of the claim language limit its scope." That is, because the claim itself limits the structure, and does not cover all conceivable structures, it only covers the structure expressly stated in the claim. Thus, 35 U.S.C. §112, ¶6 does not apply.

The Federal Circuit's application is exactly how 35 U.S.C. §112, ¶6 is written. Title 35 U.S.C. §112, ¶6 expressly requires the lack of structure, i.e., "means," to perform the claimed function. If the element recites the precise structure that performs the claimed function, §112, ¶6 does not apply.

The Federal Circuit's application of 35 U.S.C. §112, ¶6 is wholly consistent with policy of the enactment of the statue which was caused by *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 9-12 (1946). *Halliburton Oil* held that claims including "means-plus-function" elements that did not recite structure to perform the function were invalid for being too broad and vague. Thus, 35 U.S.C. §112, ¶6 was enacted to limit "means-plus-function" elements that did not recite structure in the claim. However, if a claim element recites the precise structure that performs the function – whether or not it also includes the word "means" – it is *not* too broad and vague, as the recited structure in the claim limits the claim, and the statute is not required to limit the claims.

In the present case, the '839 Patent has one independent claim, which states the following, with the last paragraph (in bold) being in issue:

> An implantable device for fixation of at least one fractured bone fragment to a stable bone fragment, said implantable device comprising:

an implantable plate having opposite end portions, fastening means for securing one end portion of said plate to stable bone,

at least one fixation pin for penetrating said at least one fractured bone fragment, and traversing a fracture for entering the stable bone fragment and for being secured therein at a stable fixation site at a far end of said fixation pin,

the opposite, near end of said pin being adapted for extending from the fractured bone fragment,

said near end of said pin being engageable in one of a plurality of holes in the other end portion of the plate,

said holes in said plate providing means for allowing the pin to slide axially therein but preventing compression across the fracture, and stabilizing said near end of the pin against displacement in the plane of the plate.

The claim element at issue is "*said holes in said plate providing means* for allowing the pin to slide axially therein but preventing compression across the fracture, and stabilizing said near end of the pin against displacement in the plane of the plate."

The holes in the plate, as expressly stated in the claim element, is the structure that performs the function – the hole (the interior portion) allows the pins to slide axially thus preventing compression across the fracture, and the circumferential surface

forms the boundary of the hole and stabilizes the pin against displacement in the plane of the plate. Because the holes are the structure and it is expressly present in the claim, there is structure in the claimed element, and thus, the element is not governed by 35 U.S.C. §112, ¶6.

The opinion by the Federal Circuit is entirely consistent with the Statute. In applying the precise language of 35 U.S.C. §112, ¶6, the Federal Circuit held that the claim element recites the structure, and is thus not governed by 35 U.S.C. §112, ¶6: "The claim language makes clear that the structure for performing these functions is the holes themselves." (Petitioner's Brief, p. 7a)

Petitioner wrongly attacks the Federal Circuit by stating that it "created a judicial exception," "engaged in an incorrect application," and has "created a loophole." Not only is Petitioner incorrect, to the contrary, the Federal Circuit has applied the statue *exactly* as written.

Whether intentionally or by oversight, Petitioner's fundamental misunderstanding of 35 U.S.C. §112, ¶6 is most evident in its statement at page 3 of its brief. Petitioner criticizes the Federal Circuit for not applying "the claim construction mandate of 35 U.S.C. §112, ¶6 to ***all*** claim elements which invoke 'means' language." Petitioner's argument that 35 U.S.C. §112, ¶6 applies to all claim elements that use the term "means" does not comport with the plain words of the statute. Petitioner refuses to acknowledge that 35

U.S.C. §112, ¶6 is only invoked when there is no recital of structure in the claim. Tellingly, instead of quoting the entire statute, Petitioner selectively leaves out the statute's key words "without the recital of structure." Petitioner's misleading quote of the statute is as follows:

> Under the statute, an applicant is allowed to claim his or her invention "as a means or step for performing a specified function," but if the applicant does so "such claim shall be construed to cover the corresponding structure, material or acts described in the specification or equivalents thereof." (Petitioner's Brief, p. 18)

However, the actual statute states:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function *without the recital of structure, material, or acts in support thereof*, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. 35 U.S.C. §112, ¶6 (emphasis added)

Petitioner's argument rings hollow when exposed to the actual words of the statute. According to Petitioner, the words "without the recital of structure" are meaningless and should be disregarded. This is plainly a misinterpretation of the law.

II. The Prosecution History Is Consistent With The Interpreted Claim and Was Not "Disregarded"

Stryker repeatedly states that TriMed and the Patent Office struck an agreement that the claim limitation at issue is a means-plus-function limitation. (Petitioner Brief, pp. 4, 10, 30) This is incorrect and misrepresents the events before the Patent Office. Specifically, on August 17, 1998, Dr. Medoff and his attorney demonstrated the invention to the examiner in person and discussed Claim 11, which became Claim 1 of the '839 Patent. The Interview Summary states the following:

> Discussion centered around focusing on the structural difference between the applicant's pin/plate attachment and the traditional screw/plate attachment . . . *The configuration of the present device allows the pin to be attached to the plate in a sliding manner that prevents compression across the fracture.* Agreement was reached that *expression of this feature in a means plus function format* and better defining the holes of the plate would distinguish over the prior art of record. Petitioner's Brief, p. SA-7 (emphasis added)

"This feature" referred to by the examiner is that of *attaching the pin and plate in a sliding manner so as to prevent compression across the fracture*, and if it had been written in means-plus-function format, would have distinguished the invention over the prior art of a thick plate with screws.

In the following amendment, TriMed went beyond drafting this limitation in means-plus-function format. Specifically, TriMed did *not* merely recite "means for allowing the pin to slide relative to the plate and prevent compression across the fracture." Rather, TriMed amended the claim by adding the exact structure of "this feature" – the holes in the plate – that perform the claimed functions. It added the entire last paragraph of the claim, which is the limitation at issue:

> *said holes in said plate providing means for allowing the pin to slide axially therein but preventing compression across the fracture, and stabilizing said near end of the pin against displacement in the plane of the plate.* (Petitioner's Brief, SA-9 and SA-6, col. 6, lns. 29-32)

Thus, TriMed, in amending the claim, did more than it had to – it limited its claim by reciting the specific structure as a limitation. It claimed "holes" as the means to perform the recited function instead of stating merely "means" without any structure. Indicative that the holes provide the necessary structure is the fact that the presence of the word "means" adds absolutely nothing to the claim, and removing the word "means" has no effect whatsoever. *Cole*, 102 F.3d 524, 531. ("Here, the claim drafter's perfunctory addition of the word "means" did nothing to diminish the precise structural character of this element. It definitely did not . . . somehow magically transform

this element into a §112, ¶6 'means-plus-function' element.")

In the "Remarks" section following the aforementioned amendments, TriMed explained that the near end of the pin (which protrudes from the fracture) engages *the hole* in the plate, wherein the hole allows the pin to slide axially therein and stabilizes the pin again migration while preventing compression across the fracture. Petitioner's Brief, SA-11-SA-12.

Thus, TriMed amended the claim by adding the limitation of defining the relationship between the pin, the plate, and the holes in the plate, where the pin fixates the fracture and (1) does not cause compression because the holes in the plate allow the pin to slide axially through the fractured and stable fragment, and (2) stabilizes the end of the pin against displacement in the plane of the plate. As discussed above, the first function is performed by the interior of the hole which provides an area for the pin to axially slide, and the second function is performed by the circumferential surface of the hole which prevents the near end of the pin from moving across the hole, i.e., lateral to the plate. This relationship excluded the prior art of plates and screws wherein the plate fixates the fracture and the tightening of the screws into the plate compress the fracture.

III. Even Under 35 U.S.C. §112, ¶6, The Structure Disclosed in the '839 Specification Includes Plain Holes

Even if the claimed element is a "means-plus-function" element and subject to 35 U.S.C. §112, ¶6, TriMed is entitled to protection covering the corresponding structure described in the specification, as well as all equivalents thereof. 35 U.S.C. §112, ¶6; *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1375 (Fed. Cir. 2003).

The '839 specification expressly states that one of the means to perform the function of allowing the pins to slide axially *are holes*. The first example in the '839 specification explains in detail how the pins 8 pass through the holes 3 in the plate and can be bent over the plate to prevent migration of the pin. (Petitioner's Brief, SA-5, SA-6, col. 4:56-col. 5:3) It also states that "the plate has distal holes 3 through which the pin 8 is passed; additionally, these holes 3 *may or may not* have slots 4." (Petitioner's Brief, SA-6, col. 5:1-3) Moreover, this is exactly what is shown in Figure 5 – the structure to perform the claimed function is the holes 3. The opinion of the Federal Circuit addressed this and stated the same: "Even if we were to construe this as a §112 ¶6 claim, the specification discloses an embodiment that has precisely the same structure that is found in the accused devices." Petitioner's Brief, 7a-8a.

Stryker argues that the specification of the '839 Patent does not disclose a plate with holes and nothing

more to perform the claimed functions. (Petitioner's Brief, pp. 8, 11 and 22) Stryker states that the '839 specification lists six different methods of locking the pin to the plate, including a slot in the plate, threaded holes with threaded pins, a locking nut, an undersized hole with a cut, a slotted hole joined with an undersized hole, or a threaded or slotted stud.

Stryker conveniently fails to state that these are all *alternative embodiments* to the very first embodiment which is simply to use a plain hole as described above. In the first embodiment the use of a slot in the plate is described as optional; the '839 specification explains that the pins 8 pass through the holes 3 in the plate *which may or may not have slots*:

> The plate has distal holes 3 through which the pin 8 is passed; additionally, *these holes may or may not have slots*. Petitioner's Brief, SA-6, col. 5, lns. 1-3.

The '839 specification continues to list examples of alternative ways to stabilize the near end (the protruding end) of the pin to the plate, the first method being bending the pin over the surface of the plate:

> The fixation of the pins 8 at the pin plate 1 is accomplished in different ways in different embodiments of the invention. *In one embodiment the pins 8 are bent over the superficial surface of the plate 1 as stated above.* Petitioner's Brief, SA-6, col. 5, lns. 22-25.

Thus, the first embodiment *does not require* slots. A pin and a plate with holes are all that are required

to perform the functions of (1) allowing the pin to slide axially in the plate and (2) stabilizing the near end of the pin against displacement in the plane of the plate. No "locking structure" is required to perform the functions of allowing the axial sliding and preventing the displacement of the pin in the plane of the plate.

The other disclosed ways of stabilizing the pin to the plate include threaded pins and threaded holes, pins with locking nuts, holes with slots, and threaded studs. (Petitioner's Brief, SA-6, col. 5, lns. 25-51) However, Stryker ignores the very first embodiment which discloses a plain hole – with or without a slot – and a pin where the pin was bent over the hole. That is it – just a pin and a hole.

Stryker's argument that holes and "something more" are required in order to "lock" the pin to the plate is contrary to the specification and arguments made to the examiner during prosecution of the patent.

CONCLUSION

Petitioner has not established any compelling reasons for this Court to grant the Petition. Therefore, Respondent respectfully request that the Petition be denied.

Respectfully submitted,

LEE F. GROSSMAN
Counsel of Record
NIRO, SCAVONE, HALLER & NIRO
181 West Madison Street
Suite 4600
Chicago, Illinois 60603
(312) 236-0733

MARK M. GROSSMAN
GROSSMAN LAW OFFICES
29 South LaSalle Street
Suite 1210
Chicago, Illinois 60602
(312) 621-9000

Counsel for Respondent

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No. 07-1537

IN THE

Supreme Court of the United States

STRYKER CORPORATION,

Petitioner,

v.

TRIMED, INCORPORATED,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF

GREGORY J. VOGLER
Counsel of Record
ROBERT A. SURRETTE
MCANDREWS, HELD & MALLOY, LTD.
500 West Madison Street
Suite 3400
Chicago, IL 60661
(312) 775-8000

Attorneys for Petitioner

217097

COUNSEL PRESS
(800) 274-3321 • (800) 359-6859

RULE 14.1(b) AND 29.6 STATEMENT

Petitioner's corporate disclosure statement was set forth at page *ii* of its Petition for a Writ of Certiorari, and there are no amendments to that statement.

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This Petition For A Writ Of Certiorari ("Petition") addresses two critical areas of patent law where the Federal Circuit has allowed a patent applicant to broaden impermissibly the scope of his or her patent monopoly. First, and foremost, this Petition raises issues regarding the proper statutory construction of 35 U.S.C. § 112, ¶ 6. As enacted, this statutory provision embodied safeguards to be employed when a patent applicant chose to express his or her invention in "means for performing a specified function" language. The Federal Circuit's erosion of these safeguards through its judicially-created exception to the clear statutory language has led to an analytical framework at odds with the statutory text and unable to produce predictable or consistent results. Tellingly, Respondent does not dispute that the current landscape often produces such arbitrary results. Second, this Petition raises issues regarding the Federal Circuit's recent willingness to diminish the public notice function served by a patent's prosecution history by disregarding a patent applicant's concession concerning a patent claim feature in a bargained-for-agreement with the United States Patent and Trademark Office ("Patent Office"). Review by this Court is needed to ensure that the Patent Office, patent applicants and the public can ascertain predictably the proper scope of any given patent monopoly.

I. RESPONDENT'S ARGUMENT REGARDING THE INTERPRETATION OF 35 U.S.C. § 112, ¶ 6 HIGHLIGHTS THE SIGNIFICANT PROBLEMS CAUSED BY THE FEDERAL CIRCUIT'S ERRONEOUS STATUTORY CONSTRUCTION

In attempt to persuade this Court that its guidance is not necessary, TriMed, Incorporated ("Respondent") ignores years of Federal Circuit law and the clear text of 35 U.S.C. § 112, ¶ 6. According to Respondent, "if the claim recites structure, with or without the word 'means,' that element is not a means-plus-function element under 35 U.S.C. § 112, ¶ 6. This clear reading of the statute has been the established law." Opp'n at 9. As illustrated below, both Respondent's belief regarding the proper interpretation of § 112, ¶ 6, and Respondent's characterization of the Federal Circuit's law simply are wrong. Direction from this Court regarding the proper statutory construction of § 112, ¶ 6 will restore the safeguards that Congress intended to be in place for all "means for performing a specified function" claim elements.

A. An Important Question Of Statutory Construction Will Go Unresolved Unless This Court Grants Petitioner's Writ Of Certiorari

Stryker Corporation's ("Petitioner") Petition highlights the problematic nature of the Federal Circuit's erroneous construction of 35 U.S.C. § 112, ¶ 6. Consequently, in order to justify the current legal landscape, Respondent is forced to advance an argument that is at odds with the statutory language and that produces unworkable results. According to

Respondent, the inclusion of the statutory language "without the recital of structure, material, or acts in support thereof" means that any recital of structure in a claim element removes that element from the ambit of § 112, ¶ 6. *See, e.g.*, Opp'n at 9. Respondent's argument for denial of the instant Petition, however, suffers from two fundamental flaws.

First, Congress enacted 35 U.S.C. § 112, ¶ 6 to cure a specific problem. *See Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 28 (1997). Because this Court previously determined that functional or "means" claim elements were too indefinite, Congress enacted § 112, ¶ 6 to sanction the use of "means for performing a specified function" claim elements so long as those elements were construed according to the terms of the statute. *See Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 10-12 (1946); 35 U.S.C. § 112, ¶ 6. In particular, the statute made clear that a patent applicant was permitted to define his or her invention in solely functional language—*i.e.*, "without the recital of structure." 35 U.S.C. § 112, ¶ 6. The statute, contrary to Respondent's assertions however, does not prohibit reciting structural language in combination with functional language. In other words, the statute allows an applicant to define a claim element with functional language. When the applicant chooses to do so, it is in the applicant's discretion whether or not to recite structure. In either situation, the claim element is still subjected to the statutory mandate that it "**shall be construed** to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." *Id.* (emphasis added).

Second, Respondent's Opposition illustrates the unworkable nature of Respondent's proposed construction. Throughout its Opposition, Respondent continually flip-flops regarding what it believes to be the proper scope of § 112, ¶ 6. For example, Respondent repeatedly argues that "[t]he statute clearly states that § 112, ¶ 6 is invoked when structure is not recited in a claim." Opp'n at 1. Respondent's argument does not solve other very real problems. For example, how is a court to interpret claims that recite structure but not enough structure to perform all the claimed functions (as is the case here)? In that situation, the applicability of the judicially-created exception to § 112, ¶ 6, even under Federal Circuit decisions, becomes uncertain. This once again creates the problems addressed by this Court in *Halliburton* whereby functional claims become overbroad and ambiguous because the claim language does not delineate the true scope of the invention. *Halliburton*, 329 U.S. at 12. On the other hand, contrary to the construction adopted by the Federal Circuit and Respondent, Petitioner's proposed construction to construe all claim elements written in "means for performing a specified function" format solves the *Halliburton* problem in all instances because it ensures that all such claim elements are interpreted in accordance with the statutory safeguards of § 112, ¶ 6.

Apparently recognizing these problems, Respondent reverses course and simultaneously repeatedly argues that "Title 35 U.S.C. § 112, ¶ 6 expressly requires the lack of structure, i.e., 'means,' to perform the claimed function. If the element recites the **precise structure** that performs the claimed function, § 112, ¶ 6 does not apply." Opp'n at 10 (emphasis added.) The statute,

however, does not say "without the recital of the **precise structure** that performs the claimed function." *See* 35 U.S.C. § 112, ¶ 6. Therefore, to get around the significant problems caused by its own advocated statutory construction, Respondent has to insert words into the statutory language.[1]

Respondent's flip-flopping between two different statutory constructions highlights that the only workable reading of the clear language of § 112, ¶ 6 is that a claim element using the words "means for," plus the recital of function(s) to be performed, shall be interpreted in accordance with § 112, ¶ 6 in all circumstances. *See, e.g.*, Kimberly A. Moore, Markman *Eight Years Later: Is Claim Construction More Predictable?*, 9 Lewis & Clark L. Rev. 231, 243 (2005); William F. Lee & Eugene M. Paige, 80 J. Pat. & Trademark Off. Soc'y 251, 266 n.106 (1998). Such a construction will eliminate the unpredictable and arbitrary results caused by the Federal Circuit's current analytic framework and provide a consistent interpretation for all "means for" claims, without any loopholes, in all circumstances. This Court's guidance is therefore needed to eliminate the uncertainty produced by the Federal Circuit's judicially-created exception to 35 U.S.C. § 112, ¶ 6.

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1. Despite the use of the phrase "precise structure," Respondent's construction is essentially identical to the Federal Circuit's "sufficient structure" language. Under either approach, some claims with structure will be interpreted under the statute and in other instances claims with structure will not be interpreted under the statute, thus generating inconsistent, unpredictable and arbitrary results.

B. Respondent Ignores The Arbitrary And Capricious Results Obtained Under The Federal Circuit's Jurisprudence

Not only does Respondent misunderstand the statutory language of 35 U.S.C. § 112, ¶ 6, but additionally, Respondent over-simplifies Federal Circuit law in a further attempt to justify the existing analytical framework.

For years the Federal Circuit has erroneously construed § 112, ¶ 6. Rather than interpret all "means for performing a specified function" claim elements in accordance with the statute, the Federal Circuit has created a judicial loophole whereby if the Federal Circuit determines that a claim element recites "sufficient structure," it is removed from the ambit of § 112, ¶ 6. *See, e.g., Biomedino, LLC v. Water Techs. Corp.*, 490 F.3d 946, 950 (Fed. Cir. 2007); Petition at 3-4, 14, 19-20. This judicially-created exception for patent owners dissatisfied with the scope of their issued claims, has led to countless unpredictable and arbitrary rulings regarding the scope of claim elements written in "means for performing a specified function" format. *See* Kimberly A. Moore, 9 Lewis & Clark at 242-43; *cf.* William F. Lee & Eugene M. Paige, 80 J. Pat. & Trademark Off. Soc'y at 266-68; Petition at 15-16, 19-23. The unnecessary uncertainty created by this judicial loophole illustrates that now is an appropriate time for this Court to address the proper construction of § 112, ¶ 6.

Tellingly, Respondent fails to address or dispute that the current legal landscape abounds with uncertainty. Instead, apparently knowing that the existing analytical framework is unworkable, Respondent, in order to

rationalize the Federal Circuit's statutory construction, grossly mischaracterizes years of Federal Circuit law. Specifically, Respondent argues that under "established law" "if the claim recites structure . . . that element is not a means-plus-function element under 35 U.S.C. § 112, ¶ 6." Opp'n at 9. As previously illustrated by Petitioner, however, Respondent's statement that the recital of any structure in a "means for performing a specified function" claim element precludes the application of § 112, ¶ 6 is belied by the case law. *See supra*; *see also* Petition at 3-4, 14, 19-20. Indeed, even the cases cited by Respondent in support of its erroneous simplification of the Federal Circuit's law, state that § 112, ¶ 6 applies unless there is the recital of "sufficient structure" or "definite structure." *See* Opp'n at 9.[2]

Ultimately, Respondent's decision to ignore years of Federal Circuit law fatally undermines its argument that this Court need not address the statutory construction issues presented by Petitioner's case. In fact, it is the Federal Circuit's insertion of the judicially-created "sufficient structure" exception into the clear language of § 112, ¶ 6 that has resulted in the unpredictable, arbitrary and capricious claim construction rulings discussed in this Petition. Petition

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2. *See also Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1304 (Fed. Cir. 2005) (claim element was "sufficiently structural"); *TI Group Automotive Sys., Inc. v. VDO N. Am., L.L.C.*, 375 F.3d 1126, 1135 (Fed. Cir. 2004) ("definite structure"); *Envirco Corp. v. Clestra Cleanroom, Inc.*, 209 F.3d 1360, 1364 (Fed. Cir. 2000) (presumptive application of § 112, ¶ 6 does not apply if claim element recites "sufficient structure"); *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531 (Fed. Cir. 1996) ("definite structure").

at 19-20. Moreover, these unpredictable and arbitrary rulings resulting from the current analytical framework are typified by this case. In particular, here not only did Robert Medoff, the patent applicant, ("Applicant") and the Patent Office explicitly agreed to write the claim element at issue in means-plus-function format, but moreover, the Applicant then amended the claim element to include "means for performing the specified function" language. Supp. App. at SA-7-SA-11. It could not be any clearer that when the patent issued, both the Applicant and the Patent Office intended for the last element of claim 1 to be interpreted as a means-plus-function element under § 112, ¶ 6. Year later, however, the Federal Circuit was able to broaden impermissibly the scope of Respondent's patent by invoking its judicially-created loophole to the statutory mandate of § 112, ¶ 6.

The uncertainty that the Federal Circuit's judicially-created exception produces is the precise reason that Petitioner has sought this Court's guidance. At no point does Respondent dispute that in the current legal landscape, inconsistent rulings regarding the proper interpretation of means-plus-function elements abound. *See* Petition at 19-20. The arbitrary results generated by the Federal Circuit's judicially-created exception to the clear language of § 112, ¶ 6 illustrate that the instant Petition raises important issues of statutory construction that are appropriate for this Court to address.

II. THIS CASE IS A PROPER VEHICLE FOR THIS COURT TO ADDRESS THE SIGNIFICANCE OF A PATENT'S PROSECUTION HISTORY

Respondent does not dispute that "the record before the Patent and Trademark Office is often of critical significance in determining the meaning of the claims." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Nor does Respondent dispute that a patent applicant should be bound by any agreement struck with the Patent Office in order to secure allowance of the patent. *See, e.g., Schoenhaus v. Genesco, Inc.*, 440 F.3d 1354, 1359 (Fed. Cir. 2006); *Spring Window Fashions LP v. Novo Indus. L.P.*, 323 F.3d 989, 995 (Fed. Cir. 2003). Rather, Respondent tries to escape the fact that these fundamental principles were ignored in this case by unilaterally and after-the-fact attempting to change the terms of the Applicant's bargained-for-agreement.

A patent's prosecution history is meant to inform the public of any agreements or statements that were made regarding the scope of the patent's claims. *See Spring Windows*, 323 F.3d at 995. In this case, the prosecution history refers to an agreement between the Applicant and the Patent Office which explicitly states that the last element of claim 1 was to be written in "means-plus-function" format. Supp. App. at SA-7. Even though the Applicant amended the claim element "[i]n accordance with the determinations made at [the] interview," and even though the Applicant recited the element at issue with "means for" language followed by the recitation of function (classic means-plus-function format), Respondent now argues that the Applicant

allegedly chose to write the claim element in such a way that it surpassed any requirements of his agreement with the Patent Office. *Id.* at SA-9-SA-11; Opp'n at 14-16. The problem with Respondent's after-the-fact argument is that (1) the Applicant should have told the Patent Office back then that he was allegedly changing the bargained-for-agreement, and (2) he should not have used the agreed-to means-plus-function language. Respondent's arguments are not credible.

Even if Respondent's arguments were believed, at best Respondent has created an ambiguous record regarding the scope of the last element of claim 1. Specifically, upon reading the prosecution history, a member of the public would be left with the logical conclusion that the claim element at issue was written in means-plus-function format. After all, the Applicant agreed to do so, said he was doing so, and ultimately utilized classic means-plus-function format when amending his claim. Supp. App. at SA7-SA-11. Nowhere in the prosecution history did the Applicant expressly disavow his agreement with the Patent Office. Therefore, Respondent's argument advanced years after the patent issued that the insertion of the word "holes" in the claim element somehow altered the terms of the agreement at worst is a disingenuous and at best creates an ambiguity.

Assuming that the Applicant created an ambiguity in the prosecution history regarding his bargained-for-agreement, the Federal Circuit should have interpreted the ambiguity against Respondent. Specifically, in the interpretation of other legal instruments, to the extent ambiguities exist, they are interpreted against the

drafter. *See Mastrobuono v. Shearson Lehman Hutton, Inc.*, 514 U.S. 52, 62-63 (1995) ("[R]espondents cannot overcome the common-law rule of contract interpretation that a court should construe ambiguous language against the interest of the party that drafted it."); Restatements (Second) of Contracts § 206 (1981) ("In choosing among the reasonable meanings of a promise or agreement or a term thereof, that meaning is generally preferred which operates against the party who supplies the words or from whom a writing otherwise proceeds."). This rule of construction is eminently practical because

> [w]here one party chooses the terms of a contract, he is likely to provide more carefully for the protection of his own interests than for those of the other party. He is also more likely than the other party to have reason to know of uncertainties of meaning. Indeed, he may leave meaning deliberately obscure, intending to decide at a later date what meaning to assert. In cases of doubt, therefore, so long as other factors are not decisive, there is substantial reason for preferring the meaning of the other party.

Restatements (Second) of Contracts § 206 cmt. a; *see also Mastrobuono*, 514 U.S. at 63 n.10.

This case presents an excellent vehicle for this Court to consider the role of a patent's prosecution history generally, and more specifically to clarify that a patent and its prosecution history should be interpreted no differently than any other legal instrument. Here, as discussed above Respondent attempts to introduce an ambiguity into the prosecution history by arguing that the Applicant's claim amendment somehow trumped or altered the terms of the Applicant's bargained-for-agreement. But, only the Applicant "[had] reason to know of [the] uncertainties of [the] meaning" of his amendment. Restatements (Second) of Contracts § 206 cmt. a. Indeed, perhaps the Applicant and Respondent "[left] meaning deliberately obscure, intending to decide at a later date what meaning to assert." *Id.* Such tactics, however, thwart the public notice function served by the prosecution history, for there was no way for the public to know of the Applicant's apparent intention to violate his bargained-for-agreement. Thus, because a patent is no different from other legal instruments, in situations where the patent applicant attempts to muddy the prosecution history with ambiguous statements, those statements should be interpreted against the applicant.

For the above reasons, this Court's guidance is needed to clarify the role of a patent's prosecution history so that it can continue to be a valuable resource to the public regarding the scope of a patent's monopoly. Without such clarity, the public will no longer be able to rely on explicit statements in a patent's prosecution history when trying to determine what technologies remain in the public domain.

CONCLUSION

To restore the statutory safeguards of 35 U.S.C. § 112, ¶ 6 enacted by Congress and eroded by the Federal Circuit, and to restore the vital public notice function of a patent's prosecution history, the petition for a writ of certiorari should be granted.

Respectfully submitted,

GREGORY J. VOGLER
Counsel of Record
ROBERT A. SURRETTE
MCANDREWS, HELD & MALLOY, LTD.
500 West Madison Street
Suite 3400
Chicago, IL 60661
(312) 775-8000

Attorneys for Petitioner